Supreme Court, U.S.
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IN THE

Supreme Court of the United States

MILTON H. GREENE ARCHIVES, INC.,

Petitioner,

v.

BPI COMMUNICATIONS INC.,
Erroneously Sued As VNU Business Media, Inc., et al.,

Respondent.

On Petition For A Writ of Certiorari to the
United States Court of Appeals
for the Ninth Circuit

PETITION FOR A WRIT OF CERTIORARI

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June 22, 2009

QUESTIONS PRESENTED

(1) Whether the mere offer of pre-1964 unpublished copyrighted works to a publisher or other distributor for possible use, distribution or sale injects those works into the public domain, even if the works were never selected or used and despite that fact that the offer was made to a definitely selected group of persons for a limited purpose.

(2) Whether affirming an award of attorney fees to a prevailing Copyright Defendant, without application or analysis of the *Fogerty* factors, so far departed from the teachings of this Court and the accepted and usual course of judicial proceedings as to call for an exercise of this Court's supervisory power to prevent defeating a central purpose of the Copyright Act and causing a chilling effect on the assertion of good faith copyright claims.

PARTIES TO THE PROCEEDINGS AND CORPORATE DISCLOSURE STATEMENT PURSUANT TO RULE 29.6

Petitioner

MILTON H. GREENE ARCHIVES, INC., is an Oregon corporation. It has no parent corporation; and no publicly held company owns ten percent or more of its stock.

Respondent

BPI COMMUNICATIONS INC., merged into VNU Business Media, Inc., effective January 1, 2002, prior to the filing of this action. VNU Business Media, Inc., is a wholly owned subsidiary of VNU Group, BV, a Netherlands company. VNU Group BV was previously named VNU NV, and was previously a publicly held corporation in the Netherlands. However, VNU's shares were de-listed from the Euronext Amsterdam market on July 11, 2006, with the last day of trading on July 10, 2006. VNU has since been a privately held corporation.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner respectfully petitions for a writ of *certiorari* to review the judgment of the United States Court of Appeals for the Ninth Circuit in this case.

OPINIONS BELOW

The opinion of the Court of Appeals for the Ninth Circuit has not been reported in the official reports, but can be found at 2009 WL 766527 (9th Cir. Mar. 24, 2009). It is reprinted in the appendix hereto at p. 105a.

The memorandum decision of the United States District Court for the Central District of California denying Petitioner's application to vacate the judgment has not been reported in the official reports, but can be found at 2005 WL 1651050 (C.D. Cal. June 17, 2005). It is reprinted in the appendix hereto at p. 103a.

The memorandum decision of the United States District Court for the Central District of California regarding liability (Taylor, DJ) is reported at 378 F.Supp.2d 1189 (C.D. Cal. 2005). It is reprinted in the appendix hereto at p. 105a.

JURISDICTION

The District Court had jurisdiction over this action pursuant to 28 U.S.C. § 1338(a), because it arises under the Copyright Act, 17 U.S.C. § 101 *et seq*. The Court of Appeals entered its memorandum opinion on March 24, 2009. A petition for re-hearing was filed but was denied without action through the expiration of time on April 7, 2009. General Order 5.5.c; *In re Silicon Graphics Inc. Secur. Litig.*, 195 F.3d 521, 523-524 (9th Cir. 1999) (J. Reinhardt dissent.opn.)

The jurisdiction of this Court to review the judgment of the Ninth Circuit is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

17 U.S.C. § 505. Remedies for infringement: Costs and attorney's fees

> In any civil action under this title, the court in its discretion may allow the recovery of full costs by or against any party other than the United States or an officer thereof. Except as otherwise provided by this title, the court may also award a reasonable attorney's fee to the prevailing party as part of the costs.

STATEMENT OF THE CASE

I. General Background

Between 1953 and 1957, Milton H. Greene (a close personal friend and confidant of Marilyn Monroe) took thousands of pictures of Marilyn Monroe. Most of the photographs were never published. Milton H. Greene died in 1985. Milton H. Greene Archives, Inc. ("Greene"), is operated by Milton H. Greene's eldest son, Joshua, who came to own the photographs, to preserve and enhance his father's legacy and to commercialize the photographs.

During the early 1950s Milton Greene, who was also Marilyn Monroe's partner in Marilyn Monroe Productions, offered some of his photographs to the movie studios for advertising and promoting Marilyn's movies. The offer was made to a definitely selected group of persons for a limited purpose. Milton Greene was careful to forbid further distribution or use and the distributing agencies working with the movie studios included restrictive legends on the prints they made available to newspapers, magazines and movie theaters. Some of his photographs were selected and used by the studios for the agreed limited purpose but many, if not most, were never selected or used at all.

In 2001, Watson-Guptill Publications, a "division" of BPI Communications, Inc. ("VNU")[1], published a book by Richard Buskin entitled "Blonde Heat." The book is a sensationalized work about Marilyn Monroe which contains over a hundred photographs of Marilyn Monroe, including the seven photographs at issue in this action. VNU never sought nor acquired permission from Greene prior to including them in "Blonde Heat" and subsequent mass-marketing of the book.

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[1] VNU Business Media, Inc. ("VNU"), filed an Answer in this matter asserting it had been erroneously sued as BPI Communications, Inc., and Watson-Guptill Publications and denying liability for infringement.

II. This Litigation

Greene sued VNU for infringement of seven (7) photographs of Marilyn Monroe. The parties each filed two motions for summary judgment, but the District Court only heard oral argument regarding one issue—alleged waiver based on the Settlement Agreement in the prior *Photofest* action. Judge Taylor denied both of Greene's summary judgment motions and VNU's summary judgment motion for waiver, but by an order entered June 7, 2005, granted VNU's motion for summary judgment asserting Greene's photographs were in the public domain [App. 2a] despite the fact that Judge Taylor had previously rejected an identical public domain argument in the *Photofest* Action and *Movie Market* Actions. [App. 71a & 78a & 81a]

III. Prior Rulings Concerning the Same and Similar Photographs

Greene had previously sued Photofest for copyright infringement for unlawfully licensing photographs of Marilyn Monroe[2] and was granted summary judgment as to liability. The case then settled. Three (3) of the photographs at issue in this case were also at issue in the *Photofest* case. Greene was granted summary judgment of infringement against Photofest on those three (3) photographs. The District Court, considering the same and similar photographs and copyrights, rejected the same "general publication" argument advanced by the VNU in this case. The District Court Judge said:

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[2] *Milton H. Greene Archives, Inc. et al. v. Photofest, Inc., et al.*, Central District of California, Case No. SACV-01-648-GLT(MLGx) ("*Photofest*").

> Defendants also claim the photographs were generally published in connection with the publicity campaigns for "Bus Stop" and "The Prince and the Showgirl" when they were distributed to magazines and newspapers all over the country. Greene's claim the publication was only a limited publication. . . .[¶] ***The publication in this instance was only limited.*** Like the song in *Hirshon*, the photographs were only distributed to a limited group, the magazines and newspapers, for limited promotional purposes. *Id.*, 243 F.2d at 645. Defendants do not show any evidence ***the photographs themselves*** were distributed for sale to the public or were distributed without restrictions placed on their use." [App. 69a-70a] (emphasis added).

In another case, *Archives of Milton H. Greene LLC vs. The Movie Market, et al.*, Central District of California, Case No. CV 00-557 GLT (EEx) (*Movie Market* Action), the same District Court Judge issued a tentative ruling ***rejecting*** the claim that Greene possessed no valid copyrights based on the use of some of the photographs as part of publicity campaigns. [App. 81a-102a] The case settled thereafter.

IV. Motion For Attorneys' Fees

Judge Taylor retired from the bench on June 30, 2005, and the case was reassigned to a different District Court Judge. On July 18, 2005, VNU filed a motion seeking attorneys' fees in the amount of $770,749.65 under 17 U.S.C. § 505, Fed.R.Civ.P. 54(d) and Local Rule 54-2.2, and alternatively under Fed.R.Civ.P. 37(c)(2). VNU took advantage of the newly assigned Judge's lack of knowledge of the case and of the conduct of the parties throughout the litigation, and filed hundreds of pages of documents in an attempt to paint Greene as a villain seeking to extort money from unsuspecting innocents. VNU's motion for attorneys' fees accused Greene of engaging in abusive litigation tactics and motion practice, and asserted Greene's claims were objectively unreasonable. Each of those arguments were addressed in the briefing on appeal.

Greene's motivation had always been to enforce its rights under the Copyright Act based on what it believed were valid copyrights based on summary judgment rulings in two prior cases and in which three (3) of the photographs at issue in this case were also at issue. [App. 46a-60a, 81a-102a] Early on, Greene offered to accept $100,000 in settlement. That is less than $15,000 per infringed photograph. VNU only offered $25,000 to settle the entire case.

The amount of attorneys' fees sought by VNU was unreasonable. VNU's requested fees were nearly double those incurred by Greene.

V. The Ninth Circuit's Ruling Is Inconsistent with the Views It Articulated At Oral Argument And The Law

The Ninth Circuit heard oral argument on May 9, 2007. The Panel's Memorandum was filed almost two (2) years later, on March 24, 2009. Notably absent was any analysis by the Panel of the purported implied findings made by the District Court.

Thus, to this day, no findings have been enunciated by either of the District Judges, nor the Ninth Circuit Panel, supporting an award of attorneys' fees beyond Judge Stotler's solitary conclusion that the "foregoing facts [*i.e.*, the District Judge's finding VNU was the prevailing party and VNU "may" file a motion for attorneys' fees] afford defendant a legally enforceable instrument, making defendant the prevailing party entitled to attorneys' fees." [App. 25a] This is particularly surprising because Judge Pacz of the Ninth Circuit Court repeatedly questioned where the District Court exercised discretion to determine if an award of fees was warranted under Fogerty.[3]

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[3] See Digital File of Oral Argument @ 26:38 ["I have a more fundamental question for you about the attorneys' fees issue. It doesn't appear to me that either Judge Stotler or Judge Taylor ever really exercised their discretion under applying the *Fogerty* factors and that deciding that attorneys' fees were appropriate here"], @ 27:10 ["But there is nothing in Judge Stotler's order where she discusses any of the Fogerty factors or even makes it clear that she is exercising her discretion that attorneys' fees are warranted."], @ 27:30 ["You know, I read this several times to see what's going on here and

The Panel also inexplicably affirmed the amount of the award despite having recognized that it was unreasonable on its face and that it had an unjustified strong punitive element to it.[4]

I just fail to see . . . The District Court did what was required under Forgerty"] and @ 31:00 ["All she does is just summarize the parties' contentions and in the end she says "the foregoing facts afford defendant a legally enforceable instrument, making defendant the prevailing party entitled to attorneys' fees."]

[4] Judge Kleinfeld who sat on the Panel queried: "[H]ow do your run up $770,000.00 in attorney fees defending your right to publish pictures where you could have bought the rights for $175,000.00 maximum?" [Digital file of Oral Argument @ 22:35] Judge Kleinfeld noted: "The publisher didn't mean to lose money. It meant to make money on the books. The book is a speculation. The money that matters is that it would have been so cheap and easy to buy the right to publish the photos from the Milton Greene Archives that I'm wondering about the reasonableness of the attorneys' fees even if the hours times the rates are reasonable. The Supreme Court has advised us we should also look at the reasonableness relative to what's accomplished and what's accomplished here is to avoid paying a vastly smaller sum for amicable agreement and permission to publish the photos." [Digital file of Oral Argument @ 23:05] Judge Kleinfeld also noted: "It looks to me like there was a strong punitive element in the award of attorneys' fees. Its very far from reducing it. I frankly had trouble understanding the punitive element in light of the *Oscar*'s case and the *Martin Luther King* case. It looked to me as though those cases make this public domain issue pretty arguable." [Digital file of Oral Argument @ 33:00]

REASONS FOR GRANTING THE WRIT

I. THE NINTH CIRCUIT'S RULING CONFLICTS WITH DECISIONS OF THIS COURT AND THERE IS A NEED TO ESTABLISH CLEAR PRECEDENT FOR THE LOWER COURTS TO FOLLOW

A. The Mere Offer of Unpublished Copyrighted Works to a Publisher or Other Distributor for Possible Use, Distribution or Sale Should Not Inject those Works into the Public Domain, Especially If the Works Were Never Selected or Used and Where the Offer Was Made to a Definitely Selected Group of Persons for a Limited Purpose.

The Ninth Circuit's decision in this case has the pernicious effect of injecting millions of works created before 1978 into the public domain merely because they were offered to a publisher or other distributor for possible use, distribution or sale, without regard to whether a particular work was ever in fact selected or used and even if the offer was made to a definitely selected group of persons for a limited purpose and not for "general publication." The decision fails to correctly apply the standard for determining whether the at-issue publications were "limited" or "general" thereby effecting an undeserved forfeiture of copyright which this Court has directed must be avoided. This is an important issue of federal law on which this Court's guidance is urgently needed.

B. Affirmance of an Award of Attorney Fees to a Prevailing Copyright Defendant, Without Regard to Application or Analysis of the *Fogerty* Factors, So Far Departed from the Teachings of this Court and the Accepted and Usual Course of Judicial Proceedings as to Call for an Exercise of this Court's Supervisory Power to Prevent Defeating a Central Purpose of the Copyright Act and Causing a Chilling Effect on the Assertion of Good Faith Copyright Claims.

This Court has consistently given credence to the "American Rule" which requires each party to bear its own attorney fees unless a statute provides otherwise. *Hensley v. Eckerhart*, 461 U.S. 424, 429 (1983) (citing *Alyeska Pipeline Serv. Co. v. Wilderness Soc'y*, 421 U.S. 240 (1975)). 17. U.S.C. § 505 provides for an award of attorneys' fees to the prevailing party in a copyright infringement case, in the discretion of the District Court. However, such discretion is not unfettered.

The Ninth Circuit's decision affirmed a ruling which punished the Plaintiff by imposition of a $765,695.37 attorney fee award merely for having exercised its statutory right to sue infringers. The Plaintiff pursued its claims in good faith as evidenced by the fact similar claims had twice been held by the same trial judge to be well founded and objectively reasonable and that the very same defenses, which prevailed here, had twice before been rejected by the very same trial judge. A copyright Plaintiff should not be subjected to crippling attorneys' fees awards for pursuing their rights in good faith. *Bridgeport Music, Inc. v. Rhyme Syndicate Music*, 376 F.3d 615, 628 (6th Cir. 2004) ("It generally does not promote the purposes of the Copyright Act to award attorney fees to a prevailing defendant when the plaintiff has advanced a reasonable, yet unsuccessful claim."); *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 140 F.3d 70, 75 (1st Cir. 1998) (In close infringement cases, "the need to encourage meritorious defenses is a factor that a district court may balance against the potentially chilling effect of imposing a large fee award on a plaintiff[ ] who . . . may have advanced a reasonable, albeit unsuccessful, claim.").

The Ninth Circuit's affirmance of the attorney fee award ignores these important ideas and the mandate that no award of fees be allowed in a copyright case unless supported by application of the *Fogerty* factors. *See, e.g.*, *Fogerty v. Fantasy, Inc.*, 510 U.S. 517 (1994) ("*Fogerty*"); *Historical Research v. Cabral*, 80 F.3d 377, 379 n.1 (9th Cir. 1996); *Jackson v. Axton*, 25 F.3d 884, 890 (9th Cir. 1994). The result is Kafka-esque. Plaintiff is ordered to pay for Defendants' attorneys' fees, but does not know the reasons why. Neither the District court nor the Court of Appeals applied the *Fogerty* factors and that alone warrants granting *certiorari* and reversal of the judgment.

II. The Questions Presented Are Important

This case involves questions of exceptional importance. The Ninth Circuit's ruling is contrary to the Copyright Act and the precedents of this Court and has the unwarranted and undesirable effect of casting hundreds of thousands, if not millions, of unpublished photographs into the public domain. This Court should clearly delineate what constitutes a "limited publication" which preserves protection of works which may have been submitted to newspapers, magazines and other "publishers" for consideration (prior to 1964) but which were never distributed by such publisher.

It is equally important to maintain uniform application of the standards for awarding attorneys' fees. This ruling must be reversed to correct the injustice inflicted on a Plaintiff which acted objectively reasonable in seeking to enforce its copyrights against an infringer. This Court should not allow a bankrupting award of attorneys fees to serve as punishment for Plaintiff's privileged pursuit of its legal remedies. This Court should not allow this ruling to have a chilling effect upon copyright owners. This Court must also instruct the Circuit Courts that application and analysis of the *Fogerty* factors is the minimum requirement to satisfy due process before issuing an award of attorneys' fees in the hundreds of thousands of dollars.

III. The Appeals Court Erred in Finding a Mere Offer to Dispose or Distribute Results in a "General Publication"

A. The Court of Appeals' Overly Broad and Improper Construction of "Publication" Improperly Caused a Forfeiture

The law abhors forfeitures. *UNUM Life Ins. Co. of America v. Ward*, 526 U.S. 358, 370, 119 S.Ct. 1380, 1387 - 1388 (1999). The distinction between "general" and "limited" publication reflects an attempt by courts to mitigate the harsh forfeiture effects of a divesting general publication. *American Vitagraph, Inc. v. Levy*, 659 F.2d 1023, 1027 (9th Cir. 1981). As a result, "it takes more in the way of publication to invalidate any copyright, whether statutory or common law, than to validate it." *Id.*, quoting *Hirshon v. United Artists Corp.*, 243 F.2d 640, 645 (D.C. Cir. 1957). "General publication" has been stated to be "such a dissemination of the work of art itself among the public, as to justify the belief that it took place with the intention of rendering such work common property." *American Tobacco Co. v. Werckmeister*, 207 U.S. 284, 299-300 (1907).

In this case, the Ninth Circuit ruled:

> [t]he photographs at issue entered the public domain when Milton H. Greene permitted them to be distributed to magazines, newspapers, and local theaters. This was a general publication, not a limited publication, because 'tangible copies of a work [were] . . . made

> available to the general public.' [citations] For the pictures at issue that were submitted to studios and publicists but were not used as broadly as the others or at all, the general publication doctrine still applies, because 'an authorize offer [was] made to dispose of the work in any such manner even if . . . such disposition [did] not in fact occur.' Citing *American Vitagraph, Inc. v. Levy*, 659, F.2d 1023, 1027 (9th Cir. 1981).

It was and is a customary practice of photographers to submit hundreds of photographs for clients to select from and from which only a handful may be selected for publication. The Panel's overly broad interpretation of the "general publication" doctrine would inject every photograph, and indeed every work, ever submitted for the selection process by a publisher or distributor into the public domain, thereby causing a forfeiture of valuable intellectual property rights.

There is no indication whatsoever that Mr. Greene ever had any intent to render the photographs at issue "common property" by virtue of merely offering them for publicity purposes, and certainly NOT those photographs which were not selected for publicity use.

The Panel's overly broad interpretation of the "general publication" rule must not be allowed to stand because it effects an unfair and inappropriate forfeiture of not just Plaintiff's works but also the millions of works by other authors and owners of copyright who may have ever shown or offered their works without a copyright notice for possible publication or distribution even when those works had never been selected.

This ruling eviscerates the protective doctrine of limited publication which was designed to support the purposes of the 1909 Copyright Act. This ruling has the potential of divesting untold numbers of works of their copyright protection for virtually every author and owner of copyrights created under the 1909 Copyright Act. This ruling should not be allowed to go silently in the night creating havoc and wreaking mayhem on the rights of this Nation's precious creative artists. This Court can should announce a rule for analysis of works which are subject to the limited publication exception.

B. The Photographs Were Not "Made Available" to the General Public

"Making available" to the general public requires the attributes of sale or distribution without regard to who they are or what they propose to do with it, and mere display of the work or inclusion in newspapers, magazines and books is insufficient because the general public cannot use it, reproduce it or sell copies made of it without additional permissions from the author.

It remains undisputed that Milton H. Greene provided the photographs to a limited class of persons, the movie studios, for a limited purpose, for publicity and promotion. The newspapers and magazines were never permitted to separately distribute or sell copies of the photographs. To the extent prints were available, they would have been distributed by National Screen Services Corp. with a restrictive legend which states:

> Property of National Screen Services Corp. Licensed for display only in connection with the exhibition of this picture at your theatre. Must be returned immediately thereafter."

There is no evidence showing that the general public was given unrestricted rights to the images. It is equally clear that no other unprivileged uses were made.

Incidental distributions of prints to the public, even if it occurred (and there is no admissible evidence that it did), did not "justify the belief that it took place with the intention of rendering the work common property." Nobody buying a newspaper or magazine could reasonably hold the belief that they could republish photographs contained therein for profit or commercial gain. Merely showing that the public had access to the photographs is not sufficient. One must look to the nature of that access. The appearance of the photographs in newspapers or magazines was like the display of photographs at the theaters themselves. The fact the photographs were never put to any commercial use is further evidence the publication was limited. The public was not able to buy copies of the photographs.

The Supreme Court in *American Tobacco* instructed:

> [I]t is well to remember that the property of the author or painter in his intellectual cre-

> ation is absolute until he voluntarily parts with the same. One or many persons may be permitted to an examination under circumstances which show no intention to part with the property right, and it will remain unimpaired.

This standard has never varied since its adoption by the Supreme Court. The Second Circuit has applied it, noting that:

> The sale of copies of the work is a general publication. *Stern v. Jerome H. Remick & Co. (C.C.)* 175 F. 282. And, moreover, the reproduction in copies for sale is what the statute in Section 11 treats as though a general publication. . . . Public exhibition is not necessarily a general publication merely because the public generally is shown the work. The test of general publication is whether the exhibition of the work to the public is under such conditions as to show dedication without reservation of rights or only the right to view or inspect it without more. *American Tobacco Co. v. Werckmeister*, 207 U.S. 284, 28 S.Ct. 72, 74, 52 L.Ed. 208, 12 Ann.Cas. 595. If the conditions of publication are such that the only right is to look at the copy of the work exhibited, there is no general publication which makes the work thereafter a published work in the copyright sense. *McCarthy & Fischer v. White* (D.C.) 259 F. 364.

See, e.g., Patterson v. Century Productions, 93 F.2d 489 (2nd Cir. 1937). The Court of Appeals for the District of Columbia has applied it in *Hirshon v. United Artists Corp.*, 243 F.2d 640 (C.A.D.C. 1957) finding:

> All the record shows is that 2,500 copies of appellant's song were printed and that some 2,000 of them were distributed to broadcasting stations and professional musicians for 'plugging' purposes, chiefly through Broadcast Music Incorporated, named on the copies as a licensing agent. Not a single copy was sold. No license or other permission was given to anyone to perform or otherwise use the song. Nothing was said or done, beyond the described distribution, to give any recipient of a copy the impression that he could make any use of it without first obtaining the proprietor's license through the stated licensing agent.

Here not a single copy was sold. Distribution was limited and all copies were to be returned. Use was limited to publicity and promotion of the movies only. There simply is no evidence showing unrestricted rights were granted by Milton H. Greene or those authorized by him. It being VNU's burden to prove that unrestricted rights were granted, VNU's motion should have been denied.

C. The Photographs Were Never Addressed Separately

The District Court found that "at least six of the seven photographs appeared in the press, either accompanying an article or in an advertisement" Order at 12:7-8. [App. 15a] The District Court did not indicate which one did not appear in the press, but decided it too was in the public domain. Each photograph was a separate work deserving separate analysis. To allow otherwise would be to deprive a person of their property without due process.

IV. The Court of Appeals Affirmance of the Attorney Fee Award is Contrary to this Court's Teachings And Against Public Policy

A. The Appeals Court Improperly Approved the District Court's Failure to Conduct Any Analysis or Provide Any Findings, Regarding the *Fogerty* Factors

The District Court failed to apply or even discuss the *Fogerty* factors, other than to recite the arguments of each of the parties. [App. 27a-43a] At least two of the Panel members noted this failure at oral argument, and expressed serious concerns as to whether the District Court ever considered or applied the *Fogerty* factors. Yet the Panel's Memorandum excuses that failure by characterizing the District Court's recitation of party contentions as "discussion" and the Defendant's contentions as the

District Court's conclusions under the factors. Memorandum at 3. The Panel attempted to justify affirmance by stating:

> Though the court *did not explain in any detail* its views on each of the many issues raised by Greene, *the context*, including plaintiff's attorney's *abusive litigation tactics,* and *the decision itself make clear that the court accepted defendant's arguments.* [emphasis added]

In fact, the decision does not "make clear that the court accepted defendant's arguments" and it did not find plaintiff engaged in any abusive litigation tactics.

McCulloch teaches that the district court's failure to make a finding concerning the basis for the award of attorney's fees warrants reversal and remand for an express finding as to the basis for the award of attorney's fees. *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 815 (9th Cir. 2003) ("a district court's order on attorney's fees may be set aside if the court fails to state reasons for its decision"); *Smith v. CMTA-IAM Pension Trust*, 746 F.2d 587, 589 (9th Cir. 1984); *See also EEOC v. Bruno's Rest.*, 13 F.3d 285, 288 (9th Cir. 1993); *Stewart v. Gates*, 987 F.2d 1450, 1454 (9th Cir. 1993).

District Judge Stotler apparently erroneously believed there was no need to address the *Fogerty* factors, because she thought Judge Taylor had already determined VNU was entitled to attorneys' fees and that her sole task was to determine how much. This is evident in a sub-section B entitled "Prevailing Party" wherein Judge Stotler found that VNU was entitled to fees as follows:

> In the June 24, 1995 Judgment, Judge Taylor decreed defendant to be the "prevailing party" as defined by Fed.R.Civ.P. 56(d), Local Rule 54-2, and under 17 U.S.C. § 505. Judge Taylor also ordered that defendant may recover its costs, and directed that defendant may file a motion to recover its reasonable attorneys' fees. *Id. The foregoing facts afford defendant a legally enforceable instrument, making defendant the prevailing party entitled to attorneys' fees. See Richard S. v. Dep't of Dev. Servs.*, 317 F.3d 1080, 1086 (9th Cir. 2003). [App. 37a (emphasis added)]

At no time did District Judge Taylor ever conduct any analysis of the *Fogerty* factors, but instead deferred doing so simply noting that VNU "may" seek attorneys' fees through a motion for attorneys' fees. As shown in the fact section above, Judge Paez of the Ninth Circuit Court, who was on the panel, repeatedly challenged counsel for Defendant noting that it doesn't appear that either Judge Stotler or Judge Taylor ever really exercised their discretion under applying the *Fogerty* factors and that deciding that attorneys' fees were appropriate.

In *Fogerty*, this Court made clear that not all prevailing plaintiffs or defendants are entitled to an award of attorneys' fees. The Court taught, and the

Ninth Circuit has previously required, application of the *Fogerty* factors. The failure to consider, discuss and apply these factors is an abuse of discretion.

The Appeals Court should have applied the *Fogerty* factors to the facts of this case. Had it done so, a reversal would have resulted. VNU was certainly NOT entitled to attorneys' fees: Plaintiff had prevailed in similar actions based on the same photographs at issue in the instant case. [App. 46a-60a, 81a-102a]; Plaintiff's lawsuit was not frivolous and the issues of law in this case are based on complex facts dating back fifty years. Plaintiff's motivation in bringing this lawsuit was to defend the rights it owned against the infringing acts and the fees and costs requested by VNU are not reasonable.[5]

An award of fees would only serve to discourage copyright holders from pursuing facially valid claims. The considerations for compensation and deterrence do not justify the award of attorneys' fees to VNU. Rather, an award of attorneys' fees must be "faithful to the purposes of the Copyright Act." *Fogerty*, 510 U.S. at 534 n. 19. The "principal purpose of the [Copyright Act] is to encourage the origination of creative works by attaching enforceable property rights to them." *Diamond v. Am-Law Publ'g Corp.*, 745 F.2d 142, 147 (2nd Cir. 1984). Awarding fees to a defendant where the plaintiff pursued reasonable, though unsuccessful claims would be contrary to the purposes of the Copyright Act. *See, e.g., Berkla v. Corel Corp.*, 302 F.3d 909, 923 (9th Cir. 2002) (a denial of fees to a successful defendant was confirmed where such defense did not advance the purposes of the copyright act: "It would be inconsistent with the Copyright Act's purposes to endorse Corel's improper appropriation of Berkla's product by awarding fees"). *See also Bridgeport Music, Inc. v. Rhyme Syndicate Music*, 376 F.3d 615, 628 (6th Cir. 2004); *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 140 F.3d 70, 75 (1st Cir. 1998); *Murray Hill Publications, Inc. v. ABC Communications, Inc.*, 264 F.3d 622, 639-640 (6th Cir. 2001).

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[5] The District Court's award rewarded inefficiency, duplicate billing, vague and block billing practices, overstaffing and redacted fee bills lacking proper description of tasks. Most remarkably, the District Court's award approves first year associate billing rates of $325 per hour, staffing of nine (9) attorneys to a case, and the mounting of a veritable armada to defend against a modest claim of admitted unauthorized copying and distribution. The award is so disproportionate and inappropriate that it's immediate reversal is required.

In contrast, the cases cited by the Appeals Court involved cases where the claims asserted were not objectively reasonable. *Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.*, 122 F.3d 1211, 1229 (9th Cir. 1997); *Maljack Productions, Inc. v. Goodtimes Home Video Corp.*, 81 F.3d 881, 890 (9th Cir. 1996); and *Smith v. Jackson*, 84 F.3d 1214, 1221 (9th Cir. 1996).

In *toto*, the balancing of these considerations would have called for denial of VNU's motion for attorneys' fees.

CONCLUSION

For the foregoing reasons, this Petition for a Writ of *Certiorari* should be granted.

Respectfully submitted,

By: ______________________________

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APPENDIX

__X__ Priority
__X__ Send
______ Clsd
__X__ Enter
______ JS-5/JS-6
______ JS-2/JS-3

[STAMP]
ENTERED
CLERK,
U.S. DISTRICT COURT
JUN - 7 2005
CENTRAL DISTRICT
OF CALIFORNIA
BY _[INITIAL]_DEPUTY

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FILED
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CLERK,
U.S. DISTRICT COURT
CENTRAL DISTRICT
OF CALIFORNIA
SOUTHERN DIVISION
AT SANTA ANA
BY _[INITIAL]_DEPUTY

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

Case No. SA CV 04-635-GLT (MLGX)

MILTON H. GREENE ARCHIVES, INC.,

Plaintiff,

vs.

BPI COMMUNICATIONS, INC. et al.,

Defendants.

[STAMP] THIS CONSTITUTES NOTICE OF ENTRY AS REQUIRED BY FRCP, RULE 77(d).

ORDER ON MOTIONS FOR SUMMARY JUDGMENT

Defendant's motion for summary judgment on waiver is DENIED. Plaintiff's motion for summary judgment on infringement is DENIED. Defendant's motion for summary judgment on infringement is GRANTED. Plaintiff's motion for summary judgment on Defendant's affirmative defenses is MOOT.

I. BACKGROUND

Plaintiff claims to own copyrights in various photographs of Marilyn Monroe. Defendant published a book, *Blonde Heat*, displaying photographs of Marilyn Monroe. Plaintiff alleges it owns copyrights in seven photographs in *Blonde Heat* and Defendant infringed its copyrights by publishing the photographs without permission.

Now, Defendant moves for summary judgment on waiver and infringement, and Plaintiff moves for summary judgment on infringement and Defendant's affirmative defenses.

II. DISCUSSION

Summary judgment is proper if "there is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c).

A. Motion for Summary Judgment on Waiver

In 2003, Plaintiff settled an earlier copyright infringement suit against Photofest, Inc. In the settlement agreement, Defendant argues, Plaintiff executed broad releases intended to protect Photofest, Inc.'s customers from claims arising from Photofest, Inc.'s previous renting of photographs Plaintiff claimed to own, including the seven photographs at issue here.

Defendant contends it is a member of the class of customers Photofest, Inc. intended to protect in the settlement agreement, as it obtained the seven photographs from Photofest, Inc. and published *Blonde Heat* before the settlement agreement was executed.

Paragraph 6, the release language in the agreement, states:

> The Parties, individually and on behalf of and for each of their respective parent corporations, partners, venturers, subsidiaries, estates, or corporations connected therewith, together with their respective agents, representatives, employees, officers, directors, shareholders, attorneys, successors, *assigns* and heirs (collectively, "Affiliates") agree to

> release any and all claims . . . which the Parties and their Affiliates had, now have, claim to have had, or otherwise could have against each other which relate in any way to, or otherwise arise out of the images at issue in the PHOTOFEST Action.

(Mandelbaum Decl. Ex. A ¶ 6 (emphasis added).)

This language is very broad. As a matter of law, "assigns" would *ordinarily* include Photofest, Inc.'s "customers." But the parties have apparently provided otherwise in their agreement. In ¶ 16, they provide they "have not *assigned* any claims or rights made the subject of this Agreement." (Mandelbaum Decl. ¶ 16 (emphasis added).) In effect, Photofest, Inc. agrees it does not have any "assigns."

Based on the extrinsic evidence, the Court finds a triable issue. Howard Mandelbaum, Photofest, Inc.'s president, testified:

> It was my intention and has always been my understanding . . . that the term "assigns" in the Settlement Agreement refers to Photofest's customers. I intended, and I always have understood, that the release included any claims that potentially could arise from the use by any of Photofest's customers of photographs rented from Photofest prior to the signing of the Settlement Agreement.

(Mandelbaum Decl. ¶ 7.)[1]

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[1] For this motion only, the Court assumes Howard Mandelbaum's declaration is admissible.

In contrast, Joshua Greene, Plaintiff's president, testified:

> During settlement discussions in Photofest defendants asked that the settlement reach and include Photofest customers, and I refused that request on behalf of the settling plaintiffs in the Photofest action. It was never my intent, nor that of the Plaintiffs in the Photofest action, to release any of Photofest's customers.

(Greene Decl. ¶ 27.)[2]

The evidence raises a triable issue on the parties' intent. Defendant's motion for summary judgment on waiver is DENIED.

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[2] Numerous aspects of Joshua Greene's declaration are hearsay, (Thomas Decl. Ex. N. at 150-51 (citing testimony by Joshua Greene, who stated his understanding of the agreement is based entirely on communications from his attorney)), but the nonhearsay aspects of his declaration are sufficient to raise a triable issue. First, Joshua Greene testified he refused to include customers in the settlement agreement. From this testimony, one can reasonably infer he communicated his refusal to his attorney, who conveyed his refusal to opposing counsel in the Photofest, Inc. action. Second, Joshua Greene testified he never intended to release customers.

At the May 9, 2005 hearing, Plaintiff's attorney pointed out other items of evidence support the position taken in Joshua Greene's declaration. The Court is satisfied a triable issue is shown by the evidence now in the record.

If any party believes additional discovery is necessary as a result of this ruling, an appropriate motion may be made.

B. Cross-Motions for Summary Judgment on Copyright Infringement

To prevail on its copyright infringement claim, Plaintiff must show ownership of a valid copyright and copying of the protected aspects of the work by Defendant. *Ellison v. Robertson*, 357 F.3d 1072, 1076 (9th Cir. 2004).

1. Ownership

A certificate of registration is prima facie evidence of ownership of a copyright. *Apple Computer, Inc. v. Formula Int'l Inc.*, 725 F.2d 521, 523 (9th Cir. 1984). Based on certificates of registration, Plaintiff contends it owns copyrights for the seven photographs. (Greene Decl. ¶¶ 6-11.)

Defendant argues Plaintiff's certificates of registration list Joshua Greene as the copyright claimant, (Greene Decl. Exs. 1-6), but Joshua Greene is not the plaintiff in this case. Defendant also argues that, although Joshua Greene declares he transferred his rights in the photographs to the Archives of Milton H. Greene LLC, (Greene Decl. ¶¶ 15-18), the Archives of Milton H. Greene LLC is not the plaintiff in this case. Defendant concludes Plaintiff--Milton H. Greene Archives, Inc.--owns the copyrights. *See Silvers v. Sony Pictures Entm't, Inc.*, 402 F.3d 881, 884-85 (9th Cir. 2005) (en banc) (stating only the owner of a copyright may sue for infringement).

Here, there is evidence Plaintiff was assigned the seven copyrights. (Soni Reply Decl. ¶ 2 & Ex. L (referencing the Assignment of Copyright, assigning all rights to the copyrights to Plaintiff); Pl.'s Reply at 10 (quoting deposition testimony, in which Joshua Greene testified he transferred his rights in the photographs to Plaintiff).)

The certificates of registration constitute prima facie evidence of ownership of a copyright.

2. Validity

A certificate of registration is prima facie evidence of validity of a copyright. *Apple Computer, Inc.*, 725 F.2d at 523. Plaintiff shows evidence it has a certificate of registration for each of the seven photographs and, therefore it contends its copyrights in the photographs are presumptively valid. (Greene Decl. ¶¶ 6-11.)

Defendant argues a certificate of registration constitutes prima facie evidence of validity *if* the registration is "made before or within five years after *first publication of the work*." 17 U.S.C. § 410(c) (emphasis added). Defendant contends Plaintiff's photographs were first published in 1956 and 1957, (Def.'s Mot. Summ. J. at 14-16 (citing evidence)),[3] yet Plaintiff's certificates of registration

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[3] Plaintiff argues Defendant's evidence of publication is inadmissible. First, Plaintiff contends Defendant "does not know . . . Exhibits A-1, B-1 through B-8, C-1, D-1, E-2, F-3, G-2 through G-7 are 'true and correct copies' of certain newspaper and magazine advertisements from the 1950s . . . since he did not personally obtain [them] from the purported sources." (Pl.'s Opp'n at 6.)

This objection is overruled. Newspaper and magazine advertisements and photographs are self-authenticating. Fed. R. Evid. 902(6); *Stanley v. Darlington County Sch. Dist.*, 879 F. Supp. 1341, 1370 (D.S.C. 1995) ("Because newspapers were filed in 1994 and 2003. (Greene Decl. Exs. 1-6). Defendant argues this shows the certificates of registration were not "made before or within five years after first publication of the work." 17 U.S.C.

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are self-authenticating under Fed. R. Evid. 902(6), the court finds that the newspaper articles offered by the District are admissible."), *rev'd in part on other grounds by* 84 F.3d 707 (4th Cir. 1996). The campaign books are also self-authenticating as items bearing trade inscriptions, Fed. R. Evid. 902(7), and the publicity stills were authenticated by Plaintiff. (Def.'s Reply at 15 (citing evidence)).

Second, the advertisements and photographs are probably not correctly analyzed as being offered to prove the truth of the matter contained. However, even if they are, they fit within the "ancient documents" exception. Fed. R. Evid. 803(16) (noting "statements in a document in existence twenty years or more the authenticity of which is established" are an exception to the hearsay rule).

Third, Plaintiff argues Defendant's exhibits should be excluded because they are not originals. This objection is overruled. Under Federal Rule of Evidence 1003, a duplicate is admissible unless "a genuine issue is raised as to the authenticity of the original." Here, Plaintiff does not raise a genuine issue as to the originals' authenticity. Defendant also represents it has several of the original sources and allowed Plaintiff to review them.

Fourth, Plaintiff contends the exhibits are of very poor quality and are inadequate to serve as a basis for comparison with the genuine photographs. Plaintiff's contention is not well taken. The evidence shows that, for every copy available at the time of Plaintiff's deposition, Plaintiff conceded Defendant's copies are identical to Plaintiff's photographs. (Def.'s Reply at 7 (citing evidence).) Plaintiff's concession leaves only two photographs for the Court to compare. (Def.'s Reply at 8; Thomas Decl. Exs. A-1, WW.) As to the two photographs, Plaintiff has not pointed to any differences between the originals and the copies, and the Court was unable to find any.

The evidence is admissible.

§ 410(c). Defendant concludes Plaintiff's certificates of registration do not constitute prima facie evidence of ownership of validity. *Entm't Research Group, Inc. v. Genesis Creative Group, Inc.*, 122 F.3d 1211, 1218 (9th Cir. 1997).

Plaintiff, however, contends the 1956 and 1957 distributions are "limited publications," and "a 'limited publication' is really in the eyes of the law no publication at all." *Data Cash Sys., Inc. v. JS&A Group, Inc.*, 628 F.2d 1038, 1043 (7th Cir. 1980). Plaintiff concludes the 1956 and 1957 distributions do not constitute "first publication of the work" and the copyrights are presumptively valid.

The Court assumes, but does not decide, Defendant has the burden to show the distributions constitute a "general publication" and not a "limited publication."

a. General Publication

Under the 1909 Copyright Act,[4] an unpublished work is protected by a state common law copyright. But, when a work is published, it loses state common law protection. *La Cienega Music Co. v. ZZ Top*, 53 F.3d 950, 952-53 (9th Cir. 1995). Upon general publication of a work, the copyright owner could obtain federal protection for the published work by complying with the requirements of the

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[4] The validity of a copyright in a work distributed before 1978 is determined by the 1909 Act. *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 206 F.3d 1322, 1325 (9th Cir. 2000) ("Because all of the copied works were created before 1978, the Copyright Act of 1909 governs the validity of the initial copyrights."). Here, the photographs were first distributed in 1956 and 1957.

1909 Act. *Id.* "If the owner failed to satisfy the [1909] Act's requirements, the published work was injected irrevocably into the public domain." *Id.* at 953.

Defendant contends Plaintiff cannot satisfy the 1909 Act's requirements. Defendant argues the photographs were published without a copyright notice in Milton Greene's name and with his permission.

1.) Permission

The evidence demonstrates Milton Greene permitted publication of the photographs. Joshua Greene testified Milton Greene permitted the publicists to use the photographs to promote the motion pictures and to place the photographs in newspapers, magazines, and campaign books. (Thomas Decl. Ex. H at 100-02.) For example, a newspaper published one of the photographs in connection with an advertisement publicizing a motion picture. When asked whether the photograph's publication in the newspaper was contrary to Milton Greene's permission, Joshua Greene answered, "No." (Thomas Decl. Ex. H at 102-03.) Joshua Greene also testified use of the photographs in "an editorial press-release kind of style" in newspapers and magazines "is the appropriate intended use." (Thomas Decl. Ex. H at 88; *see also* Def.'s Reply at 5-6 (citing evidence).)

The evidence shows Milton Greene permitted publication of the photographs.

2.) Copyright Notice

Upon publication, copyright protection under the 1909 Act could be secured by affixing a copyright notice, which included the name of the copyright proprietor, to each copy of the work "published or offered for sale in the United States by the authority of the copyright proprietor." 17 U.S.C. § 10. This requires copyright notice in the name of the copyright holder, not merely in the name of the publishing newspaper, magazine, or campaign book. *N.Y. Times Co. v. Tasini*, 533 U.S. 483, 494 (2001).[5]

When a work is published in a larger copyrighted collective work, the failure to place a copyright notice on the individual work forfeits the individual's copyright. *Id.* ("Pre-1976 copyright law recognized a freelance author's copyright in a published article only when the article was printed with a copyright notice in the author's name. . . . [W]hen a copyright notice appeared only in the publisher's name, the author's work would fall into the public domain, unless the author's copyright, in its entirety, had passed to the publisher.").

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[5] While none of the photographs includes a copyright notice in Milton Greene's name, copyright language on the back of one of the photographs appears to reference "International News Photos" and "King Features Syndicate, Inc." (Pl.'s Opp'n at 15 n.13; Thomas Decl. Ex. E-1.) Copyright language on another photograph states, "Copyright 1957 Warner Bros. Pictures Distributing Corporation." (Pl.'s Opp'n at 15 n.13; Thomas Decl. Ex. F-2.)

Under the applicable law, they do not constitute sufficient copyright notice.

Plaintiff offers the declaration of Joshua Greene, who testified: "I am aware that my father, Milton H. Greene, always applied copyright notice on the back of prints he provided to the movie studios." (Greene Decl. ¶ 21.)

The Court does not admit this testimony because it is a conclusion, and without foundation. Additionally, it violates the best evidence rule. As Defendant correctly states, "the best evidence of a copyright notice on a document is the document containing the copyright notice." (Def.'s Objections Greene Decl. at 12.) Plaintiff has not provided any admissible documentary evidence of any copyright notice in Milton Greene's name affixed to any of the seven photographs. *See Taylor v. List*, 880 F.2d 1040, 1045 (9th Cir. 1989) ("Taylor [alleged] Belleville personally stopped law clerks and law books from being presented to Taylor. None of the affidavits Taylor attached as exhibits contained any facts to support the allegation. . . . A summary judgment motion cannot be defeated by relying solely on conclusory allegations unsupported by fact."). Plaintiff has not demonstrated an exception to the best evidence rule is met.

The admissible evidence shows the photographs are not affixed with a copyright notice in Milton Greene's name.[6]

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[6] Plaintiff contends the exhibits are incomplete and are unable to prove no copyright notice accompanied the photographs. Fed. R. Evid. 106. This objection is overruled. Rule 106 states, "When a writing . . . or part thereof is introduced by a party, an adverse party may require the introduction . . . of any other part . . . which ought in fairness to be considered

3.) Publication

The parties agree a publication occurs "when, by consent of the copyright owner, the original or tangible copies of a work are sold, leased, loaned, given away, or otherwise *made available* to the general public." (Pl.'s Opp'n at 13; Def.'s Reply at 2 (emphasis added).)

Courts have found publication of a photograph in a newspaper or magazine constitutes a general publication. *See, e.g., Donald Frederick Evans & Assocs., Inc. v. Cont'l Homes, Inc.*, 785 F.2d 897, 901 (11th Cir. 1986).[7] In *Roy Export Co. v. Columbia Broadcasting System, Inc.*, for example, the Second Circuit stated publication of a novel in a

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contemporaneously with it." Rule 106 does not authorize the Court to exclude evidence; instead, it permits the adverse party to include evidence. Here, Plaintiff does not seek to include other evidence.

Plaintiff also contends there is no need to affix a copyright notice where there is only a limited publication. *GCA Corp. v. Chance*, No. C-82-1063, 1982 WL 1281, at *2 (N.D. Cal. Aug. 31, 1982). Because the distributions here constitute only a limited publication, Plaintiff argues, movie studios did not affix a copyright notice in Milton Greene's name on the publicity materials. (Pl.'s Opp'n at 15 & n.13.) The Court addresses limited publication in Part II.B.2.b.

[7] Plaintiff argues *Donald Frederick Evans* is inapplicable. Plaintiff contends that, unlike *Donald Frederick Evans*, which was decided under the 1976 Act, this action is governed by the 1909 Act. But, as Defendant observes, "cases [like] *Donald Frederick Evans* addressing publication under the 1976 Act employ the same definition of publication as under the 1909 Act." (Def.'s Reply at 4.) *Donald Frederick Evans* is persuasive, and the Court follows it here.

magazine, involving "nationwide distribution," was a general publication and "unquestionably terminated the author's common-law rights." 672 F.2d 1095, 1104 (2d Cir. 1982).

Publication of a derivative work publishes whatever portion of the original work is incorporated into the derivative work. *See, e.g., Shoptalk, Ltd. v. Concorde-New Horizons Corp.*, 168 F.3d 586, 591 (2d Cir. 1999) ("[W]hen the author consents to the inclusion of his work in a derivative work, the publication of the derivative work, to the extent. . . . it discloses the original work, also constitutes publication of [the] underlying work.").[8]

Here, the photographs were published on three occasions. First, Milton Greene provided the photographs to a publicist, Warner Brothers, and Fox for dissemination to publicize the motion pictures. (*See, e.g.*, Thomas Decl. Exs. A-G, H at 80, 82, 84-

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[8] Given *Shoptalk, Ltd.*, Defendant contends whether "the Photographs appearing in the press may have been reversed, cropped, retouched, or otherwise altered from the original Photograph, thereby creating a derivative work," is "irrelevant." (Def.'s Mot. Summ. J. at 15.)

Relying on *Batjac Productions, Inc. v. GoodTimes Home Video Corp.*, 160 F.3d 1223, 1233 (9th Cir. 1998), Plaintiff argues the Ninth Circuit declined to follow *Shoptalk, Ltd.* and adopted a contrary rule. *Batjac* declined to follow the district court's decision in *Shoptalk, Ltd.*, not the Second Circuit's decision, which was issued after *Batjac*.

Batjac did not adopt a contrary rule. *See, e.g.*, Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 4.12[B][3], at 4-68 (2004) ("*Shoptalk* aligned itself with *Batjac*."). *Shoptalk, Ltd.* is persuasive authority, and the Court follows it here.

88.) Second, the photographs were published when the publicists and motion picture studios, with Milton Greene's permission, provided the photographs to the press and to theaters in campaign books. (Def.'s Mot. Summ. J. at 16 (citing evidence).) Third, at least six of the seven photographs appeared in the press, either accompanying an article or in an advertisement, and none of the photographs carried a copyright notice. (*See, e.g.*, Def.'s Mot. Summ. J. at 16; Thomas Decl. Exs. B-C, E.)

This would amount to a general publication, forfeiting any copyright Plaintiff had in the photographs. However, if the distributions can be shown to constitute a limited publication, validity may be shown and the photographs will not fall into the public domain.

b. Limited Publication

A publication is limited only where the work was distributed "(1) to a 'definitely selected group,' and (2) for a limited purpose, [3] without the right of further reproduction, distribution or sale." *White v. Kimmell*, 193 F.2d 744, 746-47 (9th Cir. 1952); *Acad. of Motion Picture Arts & Scis. v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1452 (9th Cir. 1991). "All three of the enumerated elements [must] exist or else the distribution may not be deemed limited and the copyright will not be valid." *Penguin Books U.S.A., Inc. v. New Christian Church*, 288 F. Supp. 2d 544, 556 (S.D.N.Y. 2003).

1.) Definitely Selected Group

The evidence establishes the photographs were provided to a wide group, not a definitely selected group. (*See, e.g.*, Thomas Decl. Exs. A-C.) In *Brown v. Tabb*, the Eleventh Circuit held, "Even if the persons receiving copies in fact constitute only a select group, the publication is nevertheless general if copies were available to persons not included in the group." 714 F.2d 1088, 1092 (11th Cir. 1983). Also, the general public does not constitute a definitely selected group. *See Rexnord, Inc. v. Modern Handling Sys., Inc.*, 379 F. Supp. 1190, 1197 (D. Del. 1974) (stating brochures "were freely available to customers and prospective customers" and, therefore, "the audience to which they were disseminated can hardly be regarded as restricted").

Here, Joshua Greene testified Milton Greene permitted the publicists and the motion picture studios to use the photographs to promote the motion pictures and to place the photographs in newspapers and magazines. (Thomas Decl. Ex. H at 100-02.) Copies of the photographs were available to the general public in newspapers and magazines.

Defendant also offers the declaration of David Weitzner, an entertainment marketing strategist/consultant specializing in the motion picture industry, who testified publicity photographs "were generally available upon request to members of the general public." (Weitzner Decl. ¶ 13.)[9] Defendant has shown the photographs were not distributed to a definitely selected group.

2.) For a Limited Purpose

Plaintiff argues the seven photographs were distributed to publicize the motion pictures, which constitutes a limited purpose. *Hirshon v. United Artists Corp.*, 243 F.2d 640, 645 (D.C. Cir. 1957).

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[9] Plaintiff objects to David Weitzner's testimony, arguing he has not been qualified as an expert and his testimony on the general availability of publicity photographs is improper "custom and practice" testimony.

The Court finds David Weitzner is qualified as an expert. (Weitzner Decl. ¶¶ 2-3 (summarizing his experience in academia and the motion picture industry).) The Court also finds his testimony is not improper custom and practice testimony. First, Plaintiff's personal knowledge objection is overruled. "[E]xperts may base their testimony upon information not within their personal knowledge or observation." *United States v. Dailide*, 227 F.3d 385, 392 (6th Cir. 2000); *Doe v. Cutter Biological, Inc.*, 971 F.2d 375, 385 n.10 (9th Cir. 1992). Second, Plaintiff's hearsay objection is overruled. Experts may base their opinions on otherwise inadmissible information. *Beighler v. Leoppe*, 633 F.2d 531, 533 (9th Cir. 1980). Third, Plaintiff's relevancy objection is overruled. A court may admit expert testimony of business customs and practices where it will aid the trier of fact in understanding the business in which the claims at issue arose. *United States v. Leo*, 941 F.2d 181, 196 (3d Cir. 1991). Fourth, Plaintiff argues that, to admit this custom and practice testimony, Defendant must show the entire motion picture industry invariably conducted itself in a particular way. In support, Plaintiff cites *United States v. Angwin*, 271 F.3d 786 (9th Cir. 2001). *Angwin* is inapposite, as it concerned habit evidence. This objection is overruled.

David Weitzner's testimony is admissible.

Defendant contends *Hirshon* does not expressly apply the Ninth Circuit's limited publication test and, therefore, does not expressly address whether publicity meets the limited purpose element. The *Hirshon* court's analysis, however, fits comfortably within the Ninth Circuit's test, and there is no good reason not to apply it here.

Here, there is evidence indicating use of the photographs was restricted. For example, the following is written at the bottom of one of the seven photographs: "Licensed for display only in connection with the exhibition of this picture at your theatre. Must be returned immediately thereafter." (Thomas Decl. Ex. F-2.)

Plaintiff has met the limited purpose element.[10]

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[10] Plaintiff appears to argue this finding defeats summary judgment because the restriction indicates Plaintiff did not intend to render the photographs common property. *See Am. Tobacco Co. v. Werckmeister*, 207 U.S. 284, 299-300 (1907). The Court does not agree. Plaintiff must meet all of the limited publication elements. *See, e.g., Nimmer on Copyright* § 4.13[A]1, at 4-74 ("If the distribution of copies is not limited to a [definitely] selected group, the publication will be general, not limited, *even if restrictions are placed upon the use of the work*.") (emphasis added).

Also, while *American Tobacco Co.* suggests an author's intent to dedicate his work to the general public is important in analyzing the limited publication elements, *Nimmer on Copyright* states, "This is clearly contrary to the prevailing rule, which holds . . . the forfeiture resulting from publication occurs as a matter of law regardless of intent." *Id.* § 4.13[D], at 4-79 (citing *White*, 193 F.2d at 744, a Ninth Circuit case).

3.) Without the Right of Further Reproduction, Distribution, or Sale

The distribution of the work "must preclude recipients from reproducing, distributing, or selling any copies." *Penguin Books U.S.A., Inc.*, 288 F. Supp. 2d at 557.

Defendant argues the publicists and studios not only had the right to distribute copies of the photographs, but distribution was the very reason Milton Greene provided the photographs to them. (*See, e.g.*, Thomas Decl. Ex. H at 80, 82, 84-88.) Defendant contends that, because distribution of the photographs was not prohibited--but actually encouraged--Plaintiff cannot show limited publication. Defendant also contends Plaintiff, in opposition, "ignores entirely the final, critical prong" of the limited publication test. (Def.'s Reply at 16.)

Defendant has demonstrated Plaintiff cannot meet the third element of the limited publication test. Because all three of the elements must be shown to exist, here "the distribution may not be deemed limited and the copyright will not be valid." *Penguin Books U.S.A., Inc.*, 288 F. Supp. 2d at 556.

In sum, Plaintiff has not met the validity element of its copyright infringement claim.[11] Defendant's motion for summary judgment on copyright infringement is GRANTED.[12]

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[11] Because Plaintiff cannot establish validity, the Court does not reach the "copying" element of the copyright infringement test.

III. DISPOSITION

Defendant's motion for summary judgment on waiver is DENIED. Plaintiff's motion for summary judgment on infringement is DENIED. Defendant's motion for summary judgment on infringement is GRANTED. Plaintiff's motion for summary judgment on Defendant's affirmative defenses is MOOT. Defendant is directed to submit a short proposed judgment within ten days.

DATED: June 6, 2005

/s/ GARY L. TAYLOR
GARY L. TAYLOR
UNITED STATES DISTRICT JUDGE

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[12] Because this holding is dispositive, the Court does not reach the issue of willfulness or Plaintiff's motion for summary judgment on Defendant's affirmative defenses.

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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES—GENERAL

Case No.: SA CV 04-635-GLT (MLGx)
Date: June 23, 2005

Title:
Milton H. Greene Archives, Inc.
v.
BPI Communications, Inc. et al.

PRESENT:

HON. GARY L. TAYLOR, JUDGE [INITIALED]

Lisa Bredahl	None Present
Deputy Clerk	Court Reporter

ATTORNEY(S) PRESENT FOR PLAINTIFF(S):

None Present

ATTORNEY(S) PRESENT FOR DEFENDANT(S):

None Present

PROCEEDINGS: DENIAL OF MOTION
[IN CHAMBERS] TO RECONSIDER

Plaintiff's motion to reconsider is DENIED. The Court makes no determination as to whether its ruling is contrary to an earlier ruling in another case; based upon the legal arguments and authorities presented in this case, the Court has arrived at what it believes is the correct legal conclusion. There was no need to address the photographs separately; the method of analysis was appropriate, addressing the photographs in a comprehensive manner.

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CENTRAL DISTRICT
OF CALIFORNIA
SANTA ANA OFFICE

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CENTRAL DISTRICT
OF CALIFORNIA
SOUTHERN DIVISION
AT SANTA ANA

BY __[INITIAL]__ DEPUTY

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UNITED STATES DISTRICT COURT CENTRAL DISTRICT OF CALIFORNIA— SOUTHERN DIVISION

Case No. **SACV 04-0635-GLT (MLGx)**

Location: Courtroom of the Honorable
Gary L. Taylor

Courtroom: 10D

_x_ Docketed
_x_ Copies/MTC Sent
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___ CLSD

MILTON H. GREENE ARCHIVES, INC.,
Plaintiff,
vs.
BPI COMMUNICATIONS, INC.,
WATSON-GUPTILL PUBLICATIONS,
and DOES 1 TO 10, inclusive,
Defendants.

[~~PROPOSED~~] JUDGMENT

On June 7, 2005, this Court entered its Order granting summary judgment in favor of defendant VNU Business Media, Inc. (erroneously sued as BPI Communications, Inc. and Watson-Guptill Publications) ("Defendant") and against plaintiff Milton H. Greene Archives, Inc. ("Plaintiff"), based on the Court's findings that Plaintiff does not own valid copyrights in any of the seven photographs at issue because each of the photographs was published without the requisite copyright notice and entered the public domain in the 1950s.

ACCORDINGLY, IT IS HEREBY ORDERED ADJUDGED AND DECREED:

1. That Judgment be entered against Plaintiff and in favor Defendant on each and every claim set forth in the Complaint;

2. That Plaintiff take nothing by the Complaint and that this action be dismissed on its merits;

3. That Defendant is the prevailing party in this action as defined by Federal Rule of Civil Procedure 56(d), Local Rule 54-2, and under 17 U.S.C. § 505, and that Defendant is entitled to recover its costs in the amount of $______ /~~and its attorneys' fees in the amount of $______~~/ from Plaintiff.*

THE CLERK SHALL ENTER THIS FINAL JUDGMENT.

Dated: June 23, 2005

/s/ Gary L. Taylor
The Honorable Gary L. Taylor
United States District Judge

[handwritten]
* A motion for attorneys fees may be made.

Submitted on June 15, 2005 by:

Davis Wright Tremaine LLP
ANDREW J. THOMAS
JENNIFER L. BROCKETT
JANET L. GRUMER

By: /s/ Andrew J. Thomas
Andrew J. Thomas

Attorneys for Defendant
VNU BUSINESS MEDIA, INC.
(erroneously sued as BPI Communications, Inc.
and Watson-Guptill Publications)

DAVIS WRIGHT TREMAINE LLP
265 S FIGUEROA ST, SUITE 2400
LOS ANGELES, CALIFORNIA [ILLEGIBLE]

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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

SA CV 04-635 AHS (MLGx)

ORDER GRANTING DEFENDANT VNU'S MOTION FOR ATTORNEYS' FEES AND COSTS

I.

PROCEDURAL BACKGROUND

On June 24, 2005, Judge Taylor entered judgment granting summary judgment in favor of defendant VNU Business Media, Inc. ("defendant") (erroneously sued as BPI Communications, Inc. and Watson-Guptill Publications), and against plaintiff Milton H. Greene Archives, Inc. ("plaintiff") ("June 24 Judgment") pursuant to its June 7, 2005, order on motions for summary judgment. The June 24 Judgment further authorized a motion for attorneys' fees. On June 30, 2005, Judge Taylor retired from the bench.

On July 18, 2005, defendant filed a motion for attorneys' fees. On September 6, 2005, plaintiff filed opposition. On September 12, 2005, defendant filed a reply. The Court took the matter under submission on September 14, 2005.

Having reviewed the file and proceedings held before Judge Taylor and having read and considered the arguments and authorities raised in the parties' papers, the Court grants defendant's motion for attorneys' fees in the amount of $765,695.37.

II.

SUMMARY OF THE PARTIES' CONTENTIONS

A. Defendant's Motion for Attorneys Fees

Defendant contends that it should be awarded its reasonable attorneys' fees as the prevailing party on plaintiff's copyright claim. As the June 24 Judgment establishes, defendant is the prevailing party based upon its successful defense of plaintiff's claim that defendant infringed its copyrights. In the order, Judge Taylor specifically found defendant to be the prevailing party, ordered that it recover its costs, including recovery of its reasonable attorneys' fees.

Defendant further contends that all of the factors identified by the Supreme Court and the Court of Appeals for the Ninth Circuit support a full award of fees and costs to defendant. In determining whether to award attorneys' fees, the court should first consider "the degree of success obtained." *Jackson v. Axton*, 25 F.3d 884, 890 (9th Cir. 1994) (citations omitted). The Ninth Circuit has held that, in determining whether to award attorneys' fees to a party prevailing in a copyright infringement case, courts should consider the list of nonexclusive factors approved by the Supreme Court in *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 114 S. Ct. 1023, 127 L. Ed. 2d 455 (1994). In addition to the degree of success, these factors include "frivolousness, motivation, objective unreasonableness (both in the factual and in the legal components of the case) and the need in particular circumstances to advance the considerations of compensation and deterrence." *Id.* at 534 n.19; *accord Jackson*, 25 F.3d at 890 (adopting these five factors). "The most critical factor is the degree of success obtained." *Hensley v. Eckerhart*, 461 U.S. 424, 436, 103 S. Ct. 1933, 1941, 76 L. Ed. 2d 40 (1983).

Defendant maintains that it achieved complete success by prevailing on summary judgment on each and every photograph plaintiff accused of infringement. The second factor, objective unreasonableness, also supports an award of fees. The Ninth Circuit has recognized that the pursuit of objectively unreasonable or frivolous claims alone may justify an award of fees. *See Entm't Research Group, Inc. v. Genesis Creative Group, Inc.*, 122

F.3d 1211, 1229 (9th Cir. 1997). In this case, plaintiff knew at the outset that its copyright in one of the photographs at issue had already been found by a federal court to have been forfeited through publication. Plaintiff's claim to copyright ownership was frivolous as to the remaining six photographs as well. Under the 1909 Copyright Act, a work published in a newspaper or magazine without proper copyright notice falls irrevocably into the public domain, rendering the owner's copyright invalid. *See New York Times Co. v. Tasini*, 533 U.S. 483, 494, 121 S. Ct. 2381, 150 L. Ed. 2d 500 (2001). Here, the photographs were published in a number of nationally distributed newspapers and magazines.

Defendant further contends that plaintiff's claims and continued prosecution of this litigation, in the face of mounting evidence of the widespread publication of the photographs without copyright notice, were improperly motivated. A fee award is justified because plaintiff's overzealous litigation tactics, including its abusive Rule 11 motion, needless *ex parte* practice, discovery gamesmanship, and meritless summary judgment motions, contributed to a substantial multiplication of fees.

Finally, defendant maintains that awarding attorneys fees would support considerations of compensation and deterrence. The Ninth Circuit has declared that "[f]aithfulness to the purposes of the Copyright Act is [ ] the pivotal criterion" in deciding whether to award fees." *Fogerty*, 93 F.3d at 558. Defendant's pursuit of its right to use photographs in the public domain advances the goals of the Copyright Act and warrants full compensation.

Alternatively, defendant contends that it is also entitled to recover substantial attorneys' fees under Fed. R. Civ. P. 37. Rule 37 states that if a party fails to admit the truth of an admission that later is proved to be true, the requesting party may request that the court award reasonable expenses, including attorneys' fees, incurred in making a showing of proof. Here, in response to defendant's request for admissions, plaintiff failed to admit that each of the photographs at issue were in the public domain. Defendant therefore contends it is entitled to the fees and costs it incurred after January 7, 2005 (the date of plaintiff's response) in proving that the photographs were in the public domain.

Defendant maintains that its attorneys' fees are reasonable because the rates are calculated according to the prevailing market rates in the relevant community. For example, Judge Taylor held in *Parks v. Eastwood Insurance Services, Inc.*, Case No. SA CV 02-507, that a rate of $425 per hour "is consistent with rates charged by attorneys of equivalent experience in the community [of Los Angeles]" and that "[p]laintiffs' counsel's hourly rate is proper." Here, defendant's counsel negotiated a blended rate of $325 per hour that applied to all attorney hours expended in defending the matter. This rate compares favorably with the 2002 average hourly rate for California counsel of $349 reported in the 2003 American Intellectual Property Law Association's Report of the Economic Survey (which reports 2002 data), and is well below that charged by the partners defending this action. In addition, the number of hours worked was necessary, given the difficulties associated with investigating and establishing the publication of photographs nearly a half century ago, plaintiff's aggressive litigation tactics, and the inherent expense of litigating four cross-motions for summary judgment. Defendant claims 2223.9 hours for attorney time at $325 per hour, 159.7 hours for paralegal time at $160 per hour, and total costs of $22,430.15 for a total claim of $770,749.65.[1]

B. Plaintiff's Opposition

Plaintiff contends that no attorneys' fees should be awarded in this matter, because application of the *Fogerty* factors warrants denial of defendant's motion. An award of attorneys' fees is not automatic and is left to the Court's discretion. *Fogerty*, 510 U.S. at 534. Courts have regularly exercised their discretion to deny attorneys' fees to prevailing parties in copyright actions. *See, e.g., Positive Black Talk, Inc. v. Cash Money Records, Inc.*, 394 F.3d 357, 382-83 (5th Cir. 2004).

Plaintiff maintains that the first *Fogerty* factor should be given little or no weight because plaintiff has prevailed in similar actions based on the same photographs at issue in the instant case. Plaintiff also contends that its lawsuit was not frivolous because the issues of law in this case are based on complex facts dating back fifty years. In such cases, a finding of frivolousness is unwarranted. *See Grosset & Dunlap, Inc. v. Gulf & Western Corp.*, 534 F. Supp. 606, 611 (S.D.N.Y. 1982). Factually, the case was also quite complex, requiring nearly sixteen pages for the Court's Order.

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[1] Additional attorney time claimed in the Supplemental Declaration of Andrew J. Thomas brings to total claim to $797,789.65.

Plaintiff argues that its motivation in bringing this lawsuit was to defend the rights it owned against the infringing acts of defendant, not to extort a large unwarranted payout from defendant, and that it was not objectively unreasonable in initiating this lawsuit. Where a party asserts a colorable, albeit incorrect, argument on the merits, a finding of objective reasonableness is proper. *Batjac Prods., Inc. v. Goodtimes Home Video Corp.*, 44 U.S.P.Q. 2d 1788, 1790-91 (C.D. Cal. 1997). At the time the suit commenced, plaintiff believed it possessed valid copyrights in the subject photographs. Such belief was supported by two favorable rulings at the summary judgment stage in front of Judge Taylor concerning the same and similar photographs, which led to favorable settlements. Further, plaintiff contends that defendant's claims for compensation and deterrence should be rejected. Rather than attempt in good faith to resolve this matter at the early stages, defendant offered only $25,000 and refused to accept plaintiff's offer to compromise at $100,000. Finally, the purposes of the Copyright Act would not be served by an award of fees here, as the same would only serve to discourage copyright holders from pursuing facially valid claims.

In addition, plaintiff argues that defendant is not entitled to fees pursuant to Fed. R. Civ. P. 37 because the request at issue sought an admission as to a legal conclusion, not a fact (i.e., whether the photographs at issue were in the public domain). Last, plaintiff maintains that the fees and costs requested here are not reasonable.

C. Defendant's Reply

In reply, defendant maintains that the Court should award it its reasonable attorneys' fees. Defendant contends that plaintiff's claims were frivolous and objectively unreasonable, because two of the at-issue photographs had been found to be in the public domain before this action was filed. Moreover, Judge Taylor's rulings in prior cases made clear that similarly situated photographs were in the public domain. Defendant further contends that this case was decided upon well-established legal principles and that defendant had provided plaintiff with relevant facts evidencing widespread, contemporaneous publication without copyright notice.

Defendant also contends that improper motive, though present here, is not required to justify an award of attorneys' fees. The relative financial position of the parties is also irrelevant. Here, plaintiff's exorbitant settlement demands support a fee award. A fee award would also advance the purposes of the Copyright Act. Finally, defendant maintains that it is entitled to its attorneys' fees under Rule 37(c)(2).

Defendant also contends that the blended rate of $325 is reasonable, and that its invoices are sufficiently detailed to support an award of attorneys' fees. Plaintiff's suggested deductions are unreasonable and unsupported by evidence, and the Court should reject plaintiff's selective departures from the blended rate charged by defendant's counsel. Similarly, defendant maintains that the work performed and the fees charged were reasonable. The allocation of work was reasonable, and defendant's attorneys acted reasonably in the discovery dispute.

III.

DISCUSSION

Under 17 U.S.C. § 505, the Court may award the "prevailing party" reasonable attorneys' fees in an action brought under the Copyright Act. The Court finds that defendant is entitled to recover its fees and costs under the Copyright Act. Defendant seeks to recover attorneys' fees and associated costs in the amount of $797,789.65.

A. Defendant's Objection to Plaintiff's Objections and Corrected Objections

On September 2, 2005, plaintiff filed Objections to defendant's declarations and invoices submitted in support of its motion for attorneys' fees. On September 7, 2005, plaintiff filed Corrected Objections. On September 12, 2005, defendant filed an objection to plaintiff's Objections and Corrected Objections. Defendant contends that plaintiff's Objections and Corrected Objections are in fact supplemental briefing over the 25-page limit and thus violate the Local Rules. Defendant requests that the Court strike the Objections and Corrected Objections filings on the ground that the Local Rules of this District do not permit the filing of a brief other than a motion, opposition, or reply without leave of court. *See* Local Rule 7-4, 7-6, 7-9, and 7-10.

The Court finds that because plaintiff did not seek permission before filing its Objections and Corrected Objections, the filings were procedurally improper. Defendant, however, has not argued or shown that it was prejudiced by the filings. Under the circumstances, the Court declines to strike the filings.

B. Prevailing Party

"[A] plaintiff prevails when actual relief on the merits of his claim materially alters the legal relationship between the parties by modifying the defendant's behavior in a way that directly benefits the plaintiff." *Barrios v. California Interscholastic Fed'n*, 277 F.3d 1128, 1134 (9th Cir. 2002), quoting *Fischer v. SJB-P.D. Inc.*, 214 F.3d 1115, 1118 (9th Cir. 2000). A plaintiff's ability to enforce a judgment, consent decree, or settlement agreement against the defendant materially alters the legal relationship because the plaintiff can force defendant to do something he would not otherwise be required to do. *Id.*

In the June 24, 2005 Judgment, Judge Taylor decreed defendant to be the "prevailing party" as defined by Fed. R. Civ. P. 56(d), Local Rule 54-2, and under 17 U.S.C. § 505. Judge Taylor also ordered that defendant may recover its costs, and directed that defendant may file a motion to recover its reasonable attorneys' fees. *Id.* The foregoing facts afford defendant a legally enforceable instrument, making defendant the prevailing party entitled to attorneys' fees. *See Richard S. v. Dep't. of Dev. Servs.*, 317 F.3d 1080, 1086 (9th Cir. 2003).

C. Reasonableness of Defendant's Request

The customary method for determining the reasonableness of attorneys' fees is known as the lodestar method. *Morales v. San Rafael*, 96 F.3d 359, 363 (9th Cir. 1996). According to the "lodestar" method, "[t]he most useful starting point for determining the amount of a reasonable fee is the number of hours reasonably expended on the litigation multiplied by a reasonable hourly rate." *Hensley*, 461 U.S. at 433, 103 S. Ct. at 1939. The Court may adjust the "presumptively reasonable" lodestar figure based on the factors delineated in *Kerr v. Screen Extras Guild, Inc.*, 526 F.2d 67, 69-70 (9th Cir. 1975), if any were not subsumed in the lodestar calculation.[2] *Morales*, 96 F.3d at 363. The

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[2] The factors presumably considered by the reasonable hours component or the reasonable rate component include "(1) the novelty and complexity of the issues, (2) the special skill and experience of counsel, (3) the quality of representation, . . . (4) the results obtained." *Morales*, 96 F.3d at 364, n.9, quoting *Cabrales v. County of Los Angeles*, 864 F.2d 1454,

Court, however, is not required to consider every factor. *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1158 (9th Cir. 2002). Furthermore, the amount of an award does not render the award unreasonable. *Id.*

In this case, plaintiff contests the novelty and difficulty of the issues presented; the skill needed to perform the legal services properly; and the experience, reputation, and ability of the attorneys as reason to reduce the fee. *See* Plaintiff's Opposition at 10-22. The Court finds that most of the factors cited by defendant are presumably subsumed in the initial lodestar calculation, and defendant does not justify adjusting the figure on the basis of the other *Kerr* factors. *Morales*, 96 F.3d at 364, n.9.

1. Hourly Rate

"To inform and assist the court in the exercise of its discretion, the burden is on the fee applicant to produce satisfactory evidence–in addition to the attorney's own affidavits–that the requested rates are those prevailing in the community for similar services by lawyers of reasonably comparable skill, experience, and reputation." *See Blum v. Stenson*, 465 U.S. 886, 896, n.11, 104 S. Ct. 1541, 79 L. Ed. 2d 891 (1984) (noting that courts properly require prevailing attorneys to justify the reasonableness of the requested rate or rates); *see also G&G Fire*

1464 (9th Cir. 1988); *see also Yahoo! v. Net Games, Inc.*, 329 F. Supp. 2d 1179, 1182 (N.D. Cal. 2004) (considering the contingent nature of the fee agreement as one of the factors that have been deemed subsumed in the initial lodestar calculation).

Sprinklers, Inc. v. Bradshaw, 136 F.3d 587, 601 (9th Cir. 1998) (*overruled on other grounds by Lujan v. G&G Fire Sprinklers, Inc.*, 532 U.S. 189, 121 S. Ct. 1446, 149 L. Ed. 2d 391 (2001)).

Defendant requests $325 per hour for all attorney hours expended in defending the matter, and $160 per hour for paralegals. *See* Motion at 24. To support this amount as the prevailing rate in the community for similar services by lawyers of reasonably comparable skill, experience and reputation, defendant references several Central District cases that awarded attorneys' fees based on similar rates. *See* Motion at 23; Reply at 17. Defendant further submits an affidavit from lead counsel Andrew J. Thomas, who justifies the hourly rates by listing his qualifications as well as his associates' and senior office personnel's qualifications. [(Declaration of Andrew J. Thomas ("Thomas Decl.") ¶¶ 27-30].

Plaintiff objects to the hourly rate of the attorneys because the invoices reflect that, in addition to five partners, four far less experienced associates were billed at the same rate. *See* Corrected Objections at 7. The Court finds that the requested blended hourly rate is reasonable. *In re HPL Techs., Inc. Secs. Litig.*, 366 F. Supp. 2d 912, 921 (N.D. Cal. 2005) ("blended rates typically depend on the overall billing mix including substantial time expended in discovery by junior attorneys with relatively low billing rates."); *see also In re Cendant Corp. Deriv. Action Litig.*, 232 F. Supp. 2d 327, 341 (D. N.J. 2002) (blended rate of $381 was used to calculate lodestar); *Maley v. Del Global Tech. Corp.*, 186 F. Supp 2d 358, 371 (S.D.N.Y.

2002) (blended rate of $366 used to calculate lodestar). Plaintiff also objects that the $160 per hour rate for all legal assistants is unreasonable as a matter of law. *See* Corrected Objections at 11. The Court finds that the rate of $160 per hour as to paralegals is excessive in this market and economy. *See, e.g., In re Application of Mgndichian*, 312 F. Supp. 2d 1250, 1256 (C.D. Cal. 2003) (approving paralegal award charged at $100 per hour). Accordingly, the Court reduces the award by $9,582.00.[3]

Thus, the Court calculates the lodestar amounts based on the following rates: (1) for all attorney hours expended in defending the matter, $325 per hour; (2) for paralegals, $100 per hour.

2. Hours Expended

Defendant seeks to recover attorneys' fees for 2,307.1 hours expended.[4] *See* Motion at Appendix 1; Supplemental Declaration of Andrew J. Thomas at 6. Defendant's counsel and staff incurred attorneys' fees for time spent investigating and establishing the publication of photographs, defending against plaintiff's litigation tactics, and litigating four cross-motions for summary judgment. *See* Motion at 25. Plaintiff objects to the use of block billing and the use of redactions as suspect billing methods. Block billing occurs "when one amount of time is shown for working on more than one discrete task." *Cortes v. Metropolitan Life Ins.*, 380 F. Supp. 2d 1125 (C.D. Cal. 2005). Here, the entries are for discrete tasks and are thus not "block-billed" entries. *See also Hensley*, 461 U.S. at 437 n.12 ("[C]ounsel . . . is not required to record in great detail how each minute of his time was expended. But at least counsel should identify the general subject matter of his time expenditures."). The tasks performed by the attorneys are readily ascertainable from the unredacted entries, and the invoices submitted to the Court were redacted only to the extent necessary to preserve the attorney-client privilege and the confidentiality of attorney work product.

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[3] This amount reflects the total hours requested (159.7) at the $100.00 hourly rater instead of at the $160.00 hourly rate requested by defendant. *See* Motion at Appendix 1.

[4] This amount reflects an additional 83.2 hours of attorney time spent preparing the instant motion, as claimed in the Supplemental Declaration of Andrew J. Thomas.

The Court finds that the number of hours expended on the instant litigation was reasonable, except for the time spent with respect to the preparation of this motion, which the court reduces by 37.2 hours.

3. Specific Tasks

Plaintiff objects that defendant's counsel has impermissibly charged defendant for non-billable "administrative overhead." *See* Corrected Objections at 11. The Court finds it appropriate to award attorneys' fees for clerical or secretarial tasks, but calculates the amount at the rate of $30 per hour. Plaintiff requests $2,464.00 for tasks the Court considers clerical, based on 15.4 hours at an hourly rate of $160 per hour.[5] The Court accordingly reduces the amount awarded by $2,002.00, entitling plaintiff to recover $462.00 for clerical tasks. *See Missouri v. Jenkins*, 491 U.S. 274, 288, n.10, 109 S. Ct. 2463, 105 L. Ed. 2d 229 (1989) ("[P]urely clerical or secretarial tasks should not be billed at a paralegal rate, regardless of who performs them."). The Court reduces the number of paralegal hours by 15.4, resulting in a total of 144.3 hours. Finally, plaintiff contends that defendant's counsel has impermissibly billed for in-house attorney conferences. (*Id.* at 12.). The Court finds in-house attorney conferences to be the proper subject of billing.

4. Costs

Defendant requests $22,430.15 in associated costs (Thomas Decl., ¶ 39). Plaintiff objects that the claimed costs are excessive as a matter of law, and objects specifically to the "electronic research charges" of $18,688.56. The Court reduces by one-half the costs recoverable for electronic research. Based on the lack of novelty in the instant case, and the similarity to other cases handled by defendant's counsel, the Court finds the time spent on these tasks unreasonable. Accordingly, the Court reduces the requested fee by 50%, to $9,344.28. Thus, defendant is entitled to associated costs in the amount of $13,085.87.

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[5] Most of this work is attributable to clerical tasks performed by legal assistant K. Roth and A. Burgess. *See* Plaintiff's Corrected Objections at 12, n.14.

5. Final Calculation

Taking into consideration the foregoing discussion including reducing the amount for paralegal fees and electronic research, $765,695.37 constitutes the total amount.

D. Defendant's Evidentiary Objections

Defendant objects to the deposition of Joshua Greene, filed in support of plaintiff's Objections and Corrected Objections. The Court sustains the objections to paragraphs 7 and 8. All other objections are overruled.

IV.

CONCLUSION

For the foregoing reasons, the Court grants defendant's motion for attorneys' fees and costs in the amount of $765,695.37 against plaintiff. This award consists of 2269.9 hours of attorney time at $325 per hour, 144.3 hours of paralegal time at $100 per hour, 15.4 hours of clerical time at $30 per hour, and $13,085.87 in costs. Plaintiff shall pay to counsel for defendant the sum of $765,695.37 forthwith.

IT IS SO ORDERED.

IT IS FURTHER ORDERED that the clerk shall serve a copy of this Order on counsel for all parties in this action.

DATED: March 8, 2006.

/s/ ALICEMARIE H. STOTLER
ALICEMARIE H. STOTLER
CHIEF U.S. DISTRICT JUDGE

17 U.S.C. § 505. Remedies for infringement: Costs and attorney's fees

In any civil action under this title, the court in its discretion may allow the recovery of full costs by or against any party other than the United States or an officer thereof. Except as otherwise provided by this title, the court may also award a reasonable attorney's fee to the prevailing party as part of the costs.

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Exhibit B

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

Case No. SA CV 01-0648-GLT (MLGx)

ARCHIVES OF MILTON GREENE LLC,
Plaintiff,
vs.
PHOTOFEST, INC., et al.,
Defendants.

[~~TENTATIVE~~] ORDER GRANTING IN PART MOTIONS FOR SUMMARY JUDGMENT

Calendar Item # 10

Defendant's motion for a declaration that they are not infringing is GRANTED with respect to Exhibit 3-B and DENIED with respect to all other exhibits. Plaintiffs' motion for summary judgment is DENIED with respect to Exhibit 3-B and GRANTED with respect to all other exhibits.

I. BACKGROUND

The Court will not repeat the background to this case, which is well-known to the parties. Plaintiff moved for Partial Summary Judgment of Plaintiffs' claims of Copyright Infringement with respect to the seven photographs that were the subject of

Plaintiff's original complaint in this matter. Defendant moved for a Declaratory Judgment stating they are not infringing Plaintiff's copyright.

II. DISCUSSION

Summary judgment is proper if "there is no genuine issue as to any material fact and the moving party is entitled to a judgment as a matter of law." Fed.R. Civ. P. 56(c). A fact is material if it "might affect the outcome of the suit under the governing law." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A factual dispute is genuine "if the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *Id.*

The moving party in a summary judgment motion bears the initial burden of proving the absence of a genuine issue of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). If the moving party makes this initial showing, the burden shifts to the nonmoving party to "designate specific facts showing that there is a genuine issue for trial." *Celotex*, 477 U.S. at 324 (citation omitted). In other words, the non-moving party must produce evidence that could cause reasonable jurors to disagree as to whether the facts claimed by the moving party are true. The non-moving party is not entitled to rely on the allegations of his complaint; rather he "must produce at least some 'significant probative evidence tending to support the complaint.'" *T.W. Elec. Serv., Inc. v. Pacific Elec. Contractors Ass'n*, 809 F.2d 626, 630 (9th Cir. 1987) (quoting *First Nat'l Bank v. Cities Serv. Co.*, 391 U.S. 253, 290 (1968)).

In making a summary judgment determination, the Court must view the evidence presented in the light most favorable to the non-moving party, drawing "all justifiable inferences . . . in his favor." *Anderson*, 477 U.S. at 255. If the non-moving party fails to present a genuine issue of material fact, the Court must grant summary judgment. *Celotex*, 477 U.S. at 323-24. If, however, the evidence of a genuine issue of material fact is "merely colorable" or of insignificant probative value, summary judgment is appropriate. *See Anderson*, 477 U.S. at 249-50.

A. Plaintiffs' Ownership of a Valid Copyright

In order to prevail on its copyright infringement claim, plaintiff must show (1) ownership of a valid copyright and (2) copying of the protected aspects of the work by the defendant. *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 481 (9th Cir. 2000).

1. Publication in 1956 and 1957.

Defendants claim the photographs in question were generally published during 1956 and 1957. Defendants' Cross-Motion, 5. Plaintiffs claim the publication was only a limited publication. Plaintiffs' Opposition Memorandum, 8.

If the photographs were generally published in 1956 and 1957, then the photographs were injected into the public domain and the Plaintiffs' copyrights are invalid. If the publication was only limited, then the photographs are still eligible for copyright protection. *See* 1 *Nimmer on Copyright* §§ 4.01[B], 4.13[A].

For purposes of the Copyright Act of 1909, "the date of publication" is "the earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed." *Hirshon v. United Artists Corp.*, 243 F.2d 640, 544 (D.C. Cir. 1957). However, a "limited publication" does not affect the date of publication or destroy an artist's ownership right if it "communicates the contents of [the work] to a definitely selected group and for a limited purpose and without the right of diffusion, reproduction, distribution or sale. . . . [T]he circulation must be restricted both as to persons and purpose." *White v. Kimmell*, 193 F.2d 744, 746-47 (9th Cir. 1952). "[I]t takes more publication to destroy a . . . copyright than to perfect a statutory copyright. . . . In each case the courts appear to treat the concept of 'publication' as to prevent piracy." *Id.* at 644-45. *See also*, *King v. Mister Maestro, Inc.*, 224 F. Supp. 101, (S.D.N.Y. 1963).

The publication in this instance was only limited. Like the song in *Hirshon*, the photographs were only distributed to a limited group, the magazines, for limited promotional purposes. *See* Defendants' Cross-Motion, at 8. Plaintiffs do not show any evidence that the photographs themselves were distributed for sale to the public. *See Data Cash Systems, Inc. v. JS&A Group, Inc.*, 628 F.2d 1038, 1041 (7th Cir. 1980) (distribution and sale to the general public without restriction constitutes publication); *Hirshon* (magazines manuscripts were distributed with the instruction that they may be copied and distributed further to anyone who requested copies).

Defendant also contends that Photograph 4-A was published when it was shown as part of a promotional film trailer for *Bus Stop* in theaters in 1956. But in *American Vitagraph, Inc. v. Levy*, 65 F.2d 1023 (9th Cir. 1981), the Court of Appeals stated that "it is clear that the projection or exhibition of a motion picture in theaters or elsewhere does not in itself constitute a publication." *Id.* at 1028 (quoting 1 *Nimmer* § 4.11(A).

2. Plaintiff's Prima Facie Evidence of Copyrights

To Prove prima facie ownership of a valid copyright, plaintiff can present the certificate of registration, provided the certificate was issued before the first publication of the work or within five years after the first publication. 17 U.S.C. § 410(c); *Apple Computer, Inc. v. Formula International, Inc.*, 725 F.2d 521, 523 (9th Cir. 1984). Plaintiff has presented certificates for the registration of the photographs at issue. *See* Exhibits to 2nd Amended Complaint.

B. Validity of the Copyrights

Once the plaintiff produces the certificates of registration, the defendant has the burden of proving the invalidity of the plaintiff's copyrights. *ETS-Hokin v. Skyy Spirits, Inc.*, 225 F.2d 1068, 1076 (9th Cir. 2000).

1. Abandonment

Abandonment occurs only if the copyright owner intends to surrender his rights in his work. *See* 4

Nimmer on Copyright § 13.06 (2000). "Moreover, strong authority hold[s] that an overt act evidencing such an intent is necessary to establish abandonment." *Id.* An owner's intentional, or acquiescence to, wide and general circulation of his work without his copyright notice may constitute an overt act indicating an intent to abandon a copyright. *See Lopez v. Electrical Rebuilders, Inc.*, 416 F. Supp. 1133 (C.D. Cal. 1976) (finding plaintiff's acquiescence to widespread use of work by customers and third parties without including a copyright notice was abandonment); *DeSilva Const. Corp. v. Herrald*, 213 F. Supp. 1841 (M.D. Fla. 1962) (finding intent to abandon rights where owner filed plans in public office and the public could copy them).

a. Photographs 1-A, 2-A, 2-B, 2-C, 3-A, 4-A

Defendants argue the photographs were abandoned because Greene made no attempt to register any of the photographs with a copyright or prevent others from using his photographs in books published over the course of thirty years. Defendants' evidence on this point is circumstantial: they point only to the fact Joshua Greene did not know of any action taken by his father to police the copyrights of the photographs, the fact Joshua Greene was not knowledgeable about whether Milton Greene entered into any licensing agreements, and the fact Joshua Greene was unable to locate any cease and desist letters sent by Milton Greene to people who used the photographs over the years. They also argue Greene, as Executive Producer of *The Prince* *and the Showgirl*, was aware of the publicity campaign involving the photographs and knew the stills contained no attribution to him.[1]

Even if Defendants have made the requisite showing that Milton Greene made no attempt to secure the copyright of these photographs, they do not show that the photographs were widely distributed, e.g. by showing that they were distributed to people other than newspapers or theaters for purposes other than promotion of the movie. Such limited distribution is not abandonment. *See* This Court's June 5, 2002 Order, 10:10-19. Likewise, the copy of Exhibit 2-A of Monroe that appears on the cover of Motion Picture Magazine, *see* Trope Decl., Exh. 10, does not establish abandonment because there is no indication that Milton Greene knew or should have known of the magazine's use of the picture. *See* This Court's June 5, 2002 Order, 10:20-11:6.

b. Photograph 3-B

Defendants' Exhibit 15 to the Declaration of Konrad Trope is a copy of Photo 3-B with a notice attributing the copyright to Warner Bros. Pictures Distributing Corp. and waiving copyright to magazines and newspapers, which evidences an intent that it be generally distributed. *See White v. Kim-*

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[1] Defendants' other arguments lack merit. It is not clear why the bequest of photographically unusable negatives or the failure to provide for distribution of the photographs in the will and codicil support an inference that Milton Greene abandoned his copyright in the photographs. Defendants point to no legal authority for this proposition.

mell, 193 F.2d 744, 747 (9th Cir. 1952) (finding general distribution where no limitation was put on distribution of manuscript).

The photo is promotional material that was released in conjunction with *The Prince and the Showgirl*, of which Milton Greene was Executive Producer. Thus, Greene had presumptive knowledge of the use of the photograph. In short, there is no factual issue as to whether Plaintiff abandoned this photograph. Summary judgment is Granted for Defendants regarding photograph 3-B.

2. The Contract Between Marilyn Monroe Productions ("MMP") and 20th Century Fox

The Contract Between Marilyn Monroe Productions ("MMP") and 20th Century Fox Film Corporation ("Fox") to create the motion picture *Bus Stop* provides MMP "agrees that all material created, composed, submitted, added or interpreted by the Artist [Monroe] in the performance of her services . . . shall automatically become the property of Fox who, for this purpose, shall be deemed the author thereof." Trope Decl., Exh. 1, at 22. The contract further provides: "Fox shall . . . own . . . all of the results, product and proceeds of [Monroe's] services (including . . . copyright) whether such results and proceeds consist of. . . . motion picture, mechanical or any other forms of works. . . ." Trope Decl., Exh. 1, at 22.

The parties dispute the meaning of the term "services". Plaintiffs contend "services" are limited to acting in the movie. They cite Paragraph Ten of the contract which states in pertinent part: "Productions shall cause the Artist [Monroe] to devote her services exclusively to Fox as an actress in posing and performing in the Photoplays and scenarios therefor and rehearsals and tests of or for any of the foregoing period." The reasonable interpretation of this clause is that Monroe is to work as an actress exclusively for Fox, not that her services are limited to acting. But, even if the contract were read as Plaintiffs argue it should be, stills taken from the movie and used for the purposes of promotion would be owned by Fox under the language found on page 22 of the contract.

However, nowhere does the contract say photographs taken by Greene become the property of Fox. Defendants point to no evidence that the pictures at issue are publicity stills from the movie, rather than photographs taken by Greene. On the other hand, Plaintiffs have introduced certificates showing copyright registration of the pictures, which is prima facie evidence that they were photographs shot by Greene, not stills from the movie.

3. The Contract Between MMP and Warner Bros.

Defendants claim Warner Bros. owned the publicity stills related to the *Prince and the Showgirl*, either under the original 1956 agreement between Warner Bros. and MMP, or because it acquired them when it acquired the copyright to the film in 1970. It bases its contentions on the testimony of Warner Brothers' counsel, Jeremy Williams and on Paragraph 25 of the 1956 contract between Warner

Bros. and MMP. However, that paragraph refers only to promotional materials, not to photographs. In fact, publicity photos are mentioned in paragraph 4E of the contract, which requires the transfer of the publicity stills themselves to Warner Bros. but not the transfer of the copyright. Furthermore, Greene was not hired to take photographs of Monroe and was not a party to the contract. Defendants have failed to show evidence that Warner Bros. owned the photographs under the 1956 contract. If the rights in the photographs were owned by Milton Greene, and not by MMP, then Warner Bros. could not have acquired them in the 1970 contract. *See* Plaintiffs' Opposition Memo, 7:26-8:8 (deposition testimony of Jeremy Williams).

4. Works for Hire

Under the 1909 Copyright Act, it was presumed the commissioned party had impliedly agreed to convey the copyright, along with the work itself, to the hiring party. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 744 (1989). The test for commissioned works is the "instance and expense test". Under this test, the person at whose instance and expense the work is done owns the copyright. *Brattleboro Music Pub. Co. v. Winmill Publishing Corp.*, 369 F.2d 565, 557 (2d Cir. 1966). The instance and expense test has been applied in the 9th Circuit. *See, e.g., May v. Morganelli-Heumann & Assoc.*, 618 F.2d 1363, 1368 (9th Cir. 1980). The Works for Hire doctrine is based on the presumed mutual intent of the parties--it does not operate as a matter of law. *Id.*

Defendants claim Greene was a commissioned artist under the work for hire doctrine.

With respect to *Bus Stop*, Defendants argue that, because Fox was declared by contract the author of Ms. Monroe's work, the publicity stills were a work for hire. As discussed above, Defendants have pointed to no evidence the publicity stills fall within the contract with MMP. Furthermore, Defendants point to no evidence Fox commissioned Greene to create publicity stills. With respect to *The Prince and the Showgirl*, Defendants maintain Exhibits 31 and 32 to the Trope Declaration show Greene was involved in creating the publicity stills. Exhibit 31 is a contract in which Fox hired a photographer, Elliott Erwitt, to take publicity photographs for *The Prince and the Showgirl*. Exhibit 32 is a letter that states Greene delivered photographs and negatives to Fox. These two exhibits do not show Greene was commissioned to create the photographs. They do not establish the photographs for *The Prince and The Showgirl* were works for hire.

5. Derivative works

Defendant claims the at-issue pictures were derivative works of the movies *The Prince and the Showgirl* and *Bus Stop*. A derivative work is a work based upon a preexisting work, such as a motion picture. 17 U.S.C. § 101. Defendants argue a still depicting one frame in a motion picture is a derivative work of that motion picture. Defendants argue that, since Warner Bros. and Fox own the copyrights in the motion pictures, and the photographs at issue are stills from the motion picture, they also own the copyrights in the photographs.[2] As discussed above, by introducing copyright certificates, Plaintiffs have made a prima facie showing Milton Greene took the at-issue photos of Monroe--they are not stills from the motion pictures. Defendants have not shown the at-issue photographs were stills from the movie. Thus, Defendants' argument fails.

6. Fair Use

The fair use doctrine allows for the use of copyrighted materials under certain circumstances. 17 U.S.C. § 107, which codifies the fair use defense reads, "the fair use of a copyrighted work. . . . for purposes such as . . . news reporting, teaching . . . scholarship or research, is not an infringement of copyright." To determine whether a use is fair, a Court must consider the following four non-exclusive factors: (1) the purpose and character of the use, i.e. whether it is commercial or non-profit; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; (4) the effect of the use upon the potential market for the value of the copyrighted work. *See Harper & Row*

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[2] Defendants also maintain the publicity stills, kits, and promotional trailers are derivative works of the motion pictures, and thus Greene abandoned his copyrights in the photographs when these were distributed. As was already noted, use of Greene's photographs for the limited purpose of promotion does not constitute abandonment.

Publishers, Inc. v. National Enterprises, 471 U.S. 539, 560 (1985).

Factor 1: Photofest clearly uses the Monroe photographs commercially in that it lends them out for a fee of $40-$200 per photograph.[3] Defendant's Cross-Motion, 3.

Factor 2: The works at issue are creative in nature. Photographs are creative works. *See* Defendant's Cross-Motion, 19.

Factor 3: Defendant rents out the entire photographs, not mere portions of the photographs. Hence, it uses each copyrighted work in its entirety.

Factor 4: Market harm is presumed where the copyrighted works are used for commercial gain. *See Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 451, 104 S.Ct. 774, 78 L. Ed.2d 574 (1984). In this case, the presumption is accurate. As Plaintiffs point out, if Photofest were not infringing its copyrights, others would have to obtain their copies from Plaintiffs.

There is no significant evidence to create a triable issue as to the fair use defense in this case.

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[3] Defendants imply that they use the photographs for broader public purposes or educational purposes because they only rent them to scholars, publishers, authors, and researchers, hence their use is not commercial. This argument is unpersuasive, as they lend the photographs for profit to others who may or may not use them for such purposes.

7. Innocent Infringers[4]

Defendants argue that they are innocent infringers. They claim they believed, in good faith, that the photographs fell into the public domain. They base their argument on the fact that the photographs have been published in numerous sources since the mid-1950s. They also claim they were misled because the photographs they loaned did not contain copyright notice in the name of Milton H. Greene.[5]

These facts are not legally sufficient to establish a defense of innocent infringement. The user of copyrighted material must at least inquire after the true owner of the copyright in order to claim he acted innocently. *Bagdadi v. Nazar*, 84 F.3d 1194, 1200 (9th Cir. 1996). Many of the photographs introduced by Defendants as evidence do contain at least some copyright attribution, *see*, e.g. Trope Decl., Exh. 15 (copyright attributed to Warner Bros. Pictures Distributing Corp.). Defendants do not assert they made inquiries with these sources. Defendants have pointed to no evidence that would show they fulfilled their duty. *See* Nielsen Decl., Exh. K (requests 20 and 21) (no evidence of due diligence). There is no triable issue that Defendants are innocent infringers.

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[4] Because Defendants cannot claim innocent infringement, there is no need to decide whether they are willful infringers.

[5] Defendants also claim they relied on the advice of counsel. The letters from counsel that they rely on as evidence of this contention make no reference to Milton Greene or photos of Marilyn Monroe.

DATED: September 9, 2002.

/s/ GARY L. TAYLOR
GARY L. TAYLOR
UNITED STATES DISTRICT JUDGE

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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

Case No. SACV-01-648-GLT (MLGx)
Calendar item #12

MILTON H. GREENE ARCHIVES, INC.
& THE ARCHIVES OF MILTON H. GREENE, LLC.,

Plaintiffs,

vs.

PHOTOFEST, INC., et al.,

Defendants.

ORDER ON PLAINTIFFS' MOTIONS FOR PARTIAL SUMMARY JUDGMENT

Plaintiffs' motion for partial summary judgment of copyright infringement is GRANTED with respect to Exhibits 1-B, 2-E, 2-F, 2-G, 2-H, 5-A, 5-B, and 5-C, and DENIED with respect to Exhibits 2-D, 2-I, and 3-C.[1] Plaintiffs' motion for partial summary judgment of their enhanced statutory damages claim is DENIED. Plaintiffs' motion for partial summary judgment of their claim for attorney's fees is GRANTED IN PART.

I. BACKGROUND

Plaintiffs have registered the copyrights in numerous photographs taken by Milton H. Greene. The Court will not repeat the background to this case, which is well-known to the parties and has been stated by the Court in various orders. Plaintiffs moved for Partial Summary Judgment of Plaintiffs' claims (1) of Copyright Infringement with respect to the eleven photographs that were added in Plaintiff's second amended complaint in this matter; (2) that they are entitled to enhanced statutory damages for willful infringement; and (3) that they are entitled to attorney's fees.[2]

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[1] Except where otherwise noted, "exhibit" as used throughout this order refers to an exhibit to the Second Amended Complaint.

[2] Defendants move for certification of an immediate appeal pursuant to 28 U.S.C. § 1292(b). The Court does not rule on the motion at this time because it was premature when made. Defendants may renew the motion after the entry of this order.

II. DISCUSSION

Summary judgment is proper if "there is no genuine issue as to any material fact and the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c). A fact is material if it "might affect the outcome of the suit under the governing law." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A factual dispute is genuine "if the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *Id.*

The moving party in a summary judgment motion bears the initial burden of proving the absence of a genuine issue of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). If the moving party makes this initial showing, the burden shifts to the nonmoving party to "designate specific facts showing that there is a genuine issue for trial." *Celotex*, 477 U.S. at 324 (citation omitted). In other words, the non-moving party must produce evidence that could cause reasonable jurors to disagree as to whether the facts claimed by the moving party are true. The non-moving party is not entitled to rely on the allegations of his complaint; rather he "must produce at least some 'significant probative evidence tending to support the complaint.'" *T.W. Elec. Serv., Inc. v. Pacific Elec. Contractors Ass'n*, 809 F.2d 626, 630 (9th Cir.1987) (quoting *First Nat'l Bank v. Cities Serv. Co.*, 391 U.S. 253, 290 (1968)).

In making a summary judgment determination, the Court must view the evidence presented in the light most favorable to the non-moving party, drawing "all justifiable inferences . . . in his favor." *Anderson*, 477 U.S. at 255. If the non-moving party fails to present a genuine issue of material fact, the Court must grant summary judgment. *Celotex*, 477 U.S. at 323-24. If, however, the evidence of a genuine issue of material fact is "merely colorable" or of insignificant probative value, summary judgment is appropriate. *See Anderson*, 477 U.S. at 249-50.

A. Infringement

In order to prevail on their copyright infringement claims, Plaintiffs must show (1) ownership of a valid copyright and (2) infringement. *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 481 (9th Cir. 2000).

To Prove prima facie ownership of a valid copyright, a plaintiff can present the certificate of registration, provided the certificate was issued before the first publication of the work or within five years after the first publication. 17 U.S.C. § 410(c); *Apple Computer, Inc. v. Formula International, Inc.*, 725 F.2d 521, 523 (9th Cir. 1984). Plaintiff has presented certificates for the registration of the photographs at issue. Exhibits 1-B, 2-D, 2-E, 2-F, 2-G, 2-H, 2-I, and 3-C are the subject of the same copyright registrations that were at issue in Plaintiffs' first motion for partial summary judgment. The Court has already reviewed these certificates. *See* Order Granting in Part Motions for Partial Summary Judgment (Sept. 9, 2002) ("Sept. 9 Order"). The copyright certificate for exhibits 5-A, 5-B, and 5-C is attached as Exhibit 5 to the Second Amended Complaint. *See* Nielsen Decl. Ex. A.

Defendants contend the certificates cannot be prima facie evidence of validity because the photos were published more than five years before registration. This issue is dealt with below. *See* Section B.1.

To show infringement, a plaintiff must show the defendant used or authorized the use of the work in such a manner as to violate one of the exclusive rights granted the copyright owner in 17 U.S.C. § 106. 17 U.S.C. § 501(a); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 433 (1984). One of the rights enumerated in 17 U.S.C. § 106 is the right to distribute, or authorize distribution of, copies of the copyrighted work to the public by sale, transfer, rental, leasing, or lending. 17 U.S.C. § 106.

The subject photographs are maintained in Defendants' files to be loaned out to third parties. *See* Mandelbaum Decl. 196:6-16 (Ex. G to Nielsen Decl.). Defendants believe they loaned each of the photographs at issue to third parties. *Id.* at 194:10-21. Defendants then bill the third parties for the use of the photographs. *Id.* at 23:9-17.

Plaintiffs have made out a prima facie case of infringement regarding the subject photographs.

B. Validity of the Copyrights

Once the plaintiff produces the certificates of registration, the defendant has the burden of proving the invalidity of the plaintiff's copyrights. *ETS-Hokin v. Skyy Spirits, Inc.*, 225 F.2d 1068, 1076

(9th Cir. 2000). Defendants challenge the validity of Plaintiffs' copyrights on several grounds.

1. Publication

Defendants argue at least six of the photographs attached to exhibits 2 and 3, which include exhibits 2-D, D-E, 2-F, 2-G, 2-H, 2-I, 3-C, were published. As evidence, Defendants point to the fact that the certificates corresponding to exhibits 2-D through 2-I and 3-C list some of the photos as having been published in collective works. *See* Second Amended Complaint, Exs. 2 & 3.

> Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

17 U.S.C. § 201(c).

The certificates prove only that the pictures were published in collective works. Under § 201(c) Milton Greene presumptively retained his rights in the pictures as their author. To show otherwise, Defendants would need to come forward with evidence of a transfer. No such evidence has been produced. Defendants' first publication argument fails.

Defendants also contend exhibit 5-A to the SAC was published in Norman Mailer's book *Of Women and Their Elegance* (more than 5 years before copyright registration). However, the book in which that photograph purportedly appears attributes the copyright in the photographs to Milton Greene.[3] *See* Susolik Decl., Ex. 8. The registration certificate for ex. 5-A that notes all rights in the photograph were transferred by its author, Milton Greene, to Joshua Greene by will. *See* SAC, Ex. 5. Thus, publication in the Mailer book only reaffirms Plaintiffs' ownership of the copyright in exhibit 5-A.

Defendants next argue exhibit 2-H was published in 1987 in Lawrence Crown's book, *Marilyn at Twentieth Century Fox*. Plaintiffs argue the photograph appearing in the Crown book is not the same photograph as exhibit 2-H. The picture from Crown's book is clearly different from Ex. 2-H. *See* Susolik Decl. Ex. 9.

Defendants contend exhibit 2-I was published in 1974 in John Kobal's book, *Marilyn Monroe Her Life on Film*. The photograph in Kobal's book is also remarkably similar to exhibit 2-I. *See* Susolik Decl., Ex. 5. Kobal's book does not attribute the copyright in the photo to Milton Greene. Plaintiffs argue exhibit 2-I was not published because there is no evidence Greene gave his consent for the use of the photo, and publication under the 1909 copyright act required consent. *See Nimmer on Copyright*, § 4.04. Defendants' evidence is enough to create an inference of consent and a triable issue of fact whether Plaintiffs own the copyright to exhibit 2-I.[4]

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[3] Plaintiffs dispute whether the photograph that appears in the book is, in fact, photograph 5-A.

Defendants contend exhibit 2-D was published in 1991 in Nikki Giles' compilation, *The Marilyn Album* with photographic acknowledgment given to the British Film Institute. The picture quality is so poor on the Exhibit submitted to the Court that an accurate comparison is impossible. Because the page number does not appear underneath the photograph, it is impossible to tell to whom the photograph is attributed. *See* Susolik Decl., Ex. 6. However, the Court notes Greene is not mentioned in the acknowledgments section of that book. *Id.* There is a triable issue of fact as to whether Plaintiffs own the copyright to exhibit 2-D.

Defendants next argue Exhibit 3-C was published in 1999 in Diane Karanikas Harvey's book, *Marilyn, a Life in Pictures*. This publication is irrelevant because it took place after Plaintiffs' copyright in the photograph was registered, and there is no evidence that Plaintiffs committed an overt act that would constitute abandonment of that right. *See* Section B.2., *infra* (discussing abandonment).

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[4] The text cited from the Sept. 9 Order does not stand for the proposition that a photograph was not published if it appeared in a book without Greene's knowledge. *See* Order Granting in Part Motions for Partial Summary Judgment, 5:7-6:17 (Sept. 9, 2002).

Defendants also claim the photographs in question were published in connection with the publicity campaigns for "Bus Stop" and "The Prince and the Showgirl" when they were distributed to magazines and newspapers all over the country. Plaintiffs claim the publication was only a limited publication.[5]

If the photographs were generally published, they were injected into the public domain and Plaintiffs' copyrights are invalid. If the publication was only limited, the photographs are still eligible for copyright protection. *See* 1 Nimmer on Copyright §§ 4.01[B], 4.13[A].

For purposes of the Copyright Act of 1909, "the date of publication" is "the earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed." *Hirshon v. United Artists Corp.*, 243 F.2d 640, 644 (D.C. Cir. 1957). However, a "limited publication" does not affect the date of publication or destroy an artist's ownership right if it communicates the contents of [the work] to a definitely selected group and for a limited purpose, and without the right of diffusion, reproduction, distribution or sale. . . . [T]he circulation must be restricted both as to persons and purpose." *White v. Kimmell*, 193 F.2d 744, 746-47 (9th Cir. 1952). "[I]t takes more publication to destroy a . . . copyright than to perfect a statutory copyright. . . . In each case the courts appear to treat the concept of 'publication' as to prevent piracy." *Id.* at 644-45. *See also, King v. Mister Maestro, Inc.*, 224 F. Supp. 101, (S.D.N.Y. 1963).

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[5] This discussion of publication in connection with the promotion of "Bus Stop" and "The Prince and the Showgirl" refers to all of the photos except for exhibit 3-C, which is discussed in the section on abandonment below. *See* Section B.2. The Court does not decide whether exhibit 3-C was published in connection with the promotion of "The Prince and the Showgirl."

The publication in this instance was only limited. Like the song in *Hirshon*, the photographs were only distributed to a limited group, the magazines and newspapers, for limited promotional purposes. *Id.*, 243 F.2d at 645. Defendants do not show any evidence the photographs themselves were distributed for sale to the public or were distributed without restrictions placed on their use. *See Data Cash Systems, Inc. v. JS&A Group, Inc.*, 628 F.2d 1038, 1041 (7th Cir. 1980) (distribution and sale to the general public without restriction constitutes publication); *White*, 193 F.2d at 747 (general publication where manuscripts were distributed with the instruction that they may be copied and distributed further to anyone who requested copies).

2. Abandonment

Defendants also argue the copyrights in the photographs were abandoned.

Abandonment occurs only if the copyright owner intends to surrender his rights in his work. *See* 4 *Nimmer on Copyright*, § 13.06 (2000). "Moreover, strong authority hold[s] that an overt act evidencing such an intent is necessary to establish abandonment." *Id.* An owner's intentional, or acquiescence to, wide and general circulation of his work without his copyright notice may constitute an overt act indicating an intent to abandon a copyright. *See Lopez v. Electrical Rebuilders, Inc.*, 416 F. Supp. 1133 (C.D. Cal. 1976) (finding plaintiff's acquiescence to widespread use of work by customers and third parties without including a copyright notice was abandonment); *DeSilva Const. Corp. v. Herrald*, 213 F. Supp. 184 (M.D. Fla. 1962) (finding intent to abandon rights where owner filed plans in public office and the public could copy them).

Defendants argue the photographs were abandoned because no copyright attribution was made on the photos in Greene's name, and the studios printed their internal codes or designations on the photos and widely distributed them. They also argue the photos were abandoned because Greene made no attempt to register any of the photos until he died in 1985.

Exhibit 3-C is a photo of Marilyn Monroe and Lawrence Olivier, apparently used to promote Warner Brothers' film "The Prince and the Showgirl". The text on the lower left-hand side below the picture attributes copyright to the Warner Brothers Pictures Distributing Corporation and waives copyright to magazines and newspapers, which evidences an intent that the photo be generally distributed. *See White v. Kimmell* 193 F.2d 744, 747 (9th Cir. 1952) (finding general distribution where no limitation was put on distribution of manuscript). Greene was an executive producer of the film and had presumptive knowledge of the use of the photograph. *See* Sept. 9 Order at 6:1-5. Thus, Greene apparently abandoned his copyright in exhibit 3-C by acquiescing to its widespread distribution with copyright attribution to Warner Brothers.

Defendants have not shown the rest of the photographs were widely distributed, e.g. by showing that they were distributed to people other than newspapers or theaters for purposes other than promotion of the movie. As such, they have not shown acquiescence to wide and general circulation on Greene's part. They have shown no other overt act that would constitute abandonment. *See* This Court's June 5, 2002 Order, 10:10-19. The rest of the photos were not abandoned.

3. Derivative works

Defendants claim the at-issue pictures were derivative works of the movies *The Prince and the Showgirl* and *Bus Stop.* A derivative work is a work based upon a preexisting work, such as a motion picture. 17 U.S.C. § 101. Defendants argue a "still" depicting one frame in a motion picture is a derivative work of that motion picture. Defendants argue that, since Warner Bros. and Fox own the copyrights in the motion pictures, and the photographs at issue are stills from the motion pictures, they also own the copyrights in the photographs. As discussed above, by introducing copyright certificates, Plaintiffs have made a prima facie showing Milton Greene took the at-issue photos of

Monroe--they are not stills from the motion pictures. Defendants have not shown the at-issue photographs were stills from movies. Thus, Defendants' argument fails.

4. Works for Hire

Under the 1909 Copyright Act, it was presumed the commissioned party had implicdly agreed to convey the copyright, along with the work itself, to the hiring party. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 744 (1989). The test for commissioned works is the "instance and expense test". Under this test, the person at whose instance and expense the work is created owns the copyright. *Brattleboro Music Pub. Co. v. Winmill Publishing Corp.*, 369 F.2d 565, 567 (2d Cir. 1966). The instance and expense test is applied in the 9th Circuit. *See, e.g., May v. Morganelli-Heumann & Assoc.*, 618 F.2d 1363, 1368 (9th Cir. 1980).

Defendants claim the photos are works for hire. They contend Greene was not an employee of the studios, but was under an obligation to produce and deliver the photos to the studios based on the studios' financing of the films "Bus Stop" and "The Prince and the Showgirl". They argue the photos were produced at the studios' instance and expense.

Defendants point to no evidence in support of their contentions. The argument fails.

5. Fair Use

Defendants argue their use of the photos is protected by the fair use doctrine.

The Court has already determined Defendants are not entitled to a fair use defense. *See* Order Granting in Part Motions for Partial Summary Judgment (Sept. 9, 2002). It need not address the issue again here.

Plaintiff's motion for partial summary judgment of infringement is GRANTED in part with respect to exhibits 1-B, 2-E, 2-F, 2-G, 2-H, 5-A, 5-B, and 5-C, and DENIED with respect to exhibits 2-D, 2-I, and 3-C.

C. Enhanced Damages

Plaintiffs move for statutory damages for willful infringement. They ask for $150,000 per infringement for 17 infringing acts for a total of $2,550,000.

"In a case where the copyright owner sustains the burden of proving, and the court finds, that infringement was committed willfully, the court in its discretion may increase the award of statutory damages to a sum of not more than $150,000." 17 U.S.C. § 504(c)(2). Statutory damages are intended to compensate plaintiffs and deter defendants from future infringing conduct by making it clear that infringement is significantly more expensive than paying licensing fees. *Unicity Music, Inc. v. Omni Communications, Inc.*, 844 F. Supp. 504, 510 (E.D. Ark. 1994).

Courts are wary of granting summary judgment in cases where intent, willfulness, motive or good faith is at issue. *Simpson v. United States*, 652 F.2d 831, 834 (9th Cir. 1980); *Gard v. United States*, 594 F.2d 1230, 1234 (9th Cir. 1979). Infringement is willful if the defendant had knowledge that his conduct represented infringement, or recklessly disregarded the possibility. *Kepner Tregoe, Inc. v. Vroom*, 186 F.3d 283, 288 (2d Cir. 1999). Defendants claim they reasonably believed in good faith the photos had entered the public domain. They have submitted evidence in support of this claim. *See* Mandelbaum Decl., ¶¶ 2, 7, 8, 10, 11. Plaintiffs point out that Defendant Howard Mandelbaum holds himself out as an expert in copyright law even though he is not a lawyer and has no legal training; and that Defendants had no permission from Plaintiffs to loan out the photos. The Court cannot conclude as a matter of law that this evidence shows Defendants were reckless or knew the photos to be copyrighted.[6] There appears to be a triable issue. Whether Defendants acted willfully is not an appropriate issue for summary judgment at this time.

Plaintiffs' motion for partial summary judgment of entitlement to enhanced statutory damages is DENIED.

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[6] The Court has already found Defendants were not *innocent* infringers because they did not inquire into the true copyright owner of the photos, as required by caselaw. *See* Sept. 9 Order at 12:6-17; *Bagdadi v. Nazar*, 84 F.3d 1194, 1200 (9th Cir. 1996) This does not mean they acted wilfully.

D. Attorney Fees

Plaintiffs argue they are entitled to attorney's fees because Defendants infringed their copyrights. 17 U.S.C. § 505 provides the Court has discretion to award costs and attorney's fees as a remedy for copyright infringement. Defendants argue 17 U.S.C. § 412 precludes Plaintiffs from collecting statutory damages and attorney's fees because their infringement began before Plaintiffs registered the copyrights. 17 U.S.C. § 412 reads:

> In any action under [the Copyright Act) . . . no award of statutory damages or of attorney's fees, as provided by sections 504 and 505, shall be made for—
>
> (1) any infringement of copyright in an unpublished work commenced before the effective date of registration; or
>
> (2) any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work.

Plaintiffs registered their copyrights in 1994. Therefore, under § 412, if Defendants were infringing Plaintiffs' copyrights before 1994, they cannot owe statutory damages or attorney's fees as a matter of law. Defendants have come forward with no evidence that they actually lent the at-issue photos before Plaintiffs registered them. The evidence to which they have pointed shows only that Photofest has been lending out photographs since 1982. *See* Mandelbaum Decl., ¶ 2. Without evidence that they lent the at-issue photographs out before 1994, Defendants cannot avail themselves of § 412. Plaintiffs have successfully shown Defendants have infringed their copyrights in all of the photographs except for exhibits 2-D, 2-I, 3-B,[7] and 3-C. Plaintiffs are entitled to attorney's fees with respect to the photos they have shown Defendants infringed.

Plaintiffs' motion for attorney's fees is GRANTED IN PART.

DATED: February 12, 2003.

/s/ GARY L. TAYLOR
GARY L. TAYLOR
UNITED STATES DISTRICT JUDGE

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[7] *See* Jun. 9 Order, 1:15-18.

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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES—GENERAL

Case No.: SA CV 00-557 GLT (ANx)
Date: June 22, 2001

Title:
Archives of Milton Greene CCL
v.
The Movie Market Inc., et al.

DOCKET ENTRY I hereby certify that this document was served by first class mail, postage prepaid, to all counsel for parties at their respective most recent address of record in this action on this date.
date ____________

____
Deputy Clerk

PRESENT:

HON. Gary L. Taylor, JUDGE

Kathleen Gault-Peterson	None Present
Deputy Clerk	Court Reporter (SM)

ATTORNEYS PRESENT FOR PLAINTIFFS:

None Present

ATTORNEYS PRESENT FOR DEFENDANTS:

None Present

PROCEEDINGS [In Chambers]	**Order re: Plaintiff's Motion for Summary Judgement**

Attached is the Court's tentative ruling on Plaintiff's Motion for Summary Judgement and what the Court also deems as Defendants' Cross-Motion for Summary Judgement. The Court allows Plaintiff 45 days to respond to the abandonment issue Defendant may file a reply within 7 days of Plaintiff's filing its response. The briefing in this issue shall not exceed 10 pages in length per party

During the 45 days in which Plaintiff has to respond to the abandonment issue, the Court reopens discovery on the two photographs for which there appears to remain triable issues of fact, as well as the issue of the Polish government's ownership interest in the 17 photographs. By the close of briefing on the abandonment issues, Defendants are directed to advise the Court if the additional discovery reveals evidence that bears on the Motions for Summary Judgement which remain under submission. If necessary, the Court will set a briefing schedule on these issues

This ruling affects other scheduled dates in this case The new Pretrial Conference is April 5, 2002 at 1:30 p m with a trial to be set in May, 2002

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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

Case No. SA CV 00-557 GLT (EEx)

ARCHIVES OF MILTON GREENE LLC,

Plaintiff,

vs.

THE MOVIE MARKET, INC., et al.,

Defendants.

[TENTATIVE] ORDER GRANTING IN PART PLAINTIFF'S MOTIONS FOR SUMMARY JUDGEMENT AND DEFENDANTS' MOTION FOR SUMMARY JUDGEMENT

Plaintiff's Motions for Summary Judgement are GRANTED in part. The Court treats Defendants' briefs as a Cross-Motion for Summary Judgement and GRANTS the Cross-Motion in part.

I. BACKGROUND

Between 1950 and 1957, Milton Greene took many photographs of Marilyn Monroe as well as of other celebrities. He never registered any copyright notices for his photographs. When he died in 1985, many of his photos went into the residue of his estate, which was held in a trust for ten years. During this time, the photos were locked in a vault. Milton Greene's two sons, Joshua and Anthony Greene, were the beneficiaries of the trust. At the end of the trust's term, Milton Greene's sons obtained the photographs. At this time, in July 1994, Joshua Greene filled out approximately 27 copyright applications for the collection of 5,000 Marilyn Monroe photographs he received. He submitted a video tape with all the Monroe photos to the Copyright Office with the copyright applications as a single collection, as part of creating the compilation, *Milton's Marilyn*.

Joshua Greene formed Plaintiff, The Archives of Milton H. Greene, LLC, in April 1996. He transferred his rights and interests in the photos to Plaintiff, and Anthony Greene sold his rights in the photos to Plaintiff. Plaintiff has the certificate of registration for the photos. Plaintiff contends it owns the copyrights to the 17 photographs at issue in this case. It brought suit against Defendants Movie Market, Inc. and its officers, Simon and Paul Parker, for copyright infringement of the 17 at-issue photos. The Court previously denied cross-motions for summary judgement before discovery was complete. Plaintiff now brings two timely motions for summary judgement, the first addressing 5 photos, and the second addressing the remaining 12. The Court considers the motions together. The Court also construes Defendants' briefs as a Cross-Motion for Summary Judgement.

II. DISCUSSION

A. The Copyright Act

The Copyright Act of 1909 provides for a 28 year initial term of copyright protection with a 28 year renewal term. *See* 17 U.S.C. § 24; *Stewart v. Abend*, 495 U.S. 207, 212 (1990). The copyright on art expires, and the art enters the public domain, 28 years after the date of first publication (not the date of creation) if the copyright is not renewed. *See Fred Fisher Music Co. v. M. Witmark & Sons*, 318 U.S. 643, 644-645 (1943). "Copyright in a work created before January 1, 1978, but not theretofore in the public domain or copyrighted, subsists from January 1, 1978, and endures for the term provided by section 302. In no case, however, shall the term of copyright in such a work expire before December 31, 2002." 17 U.S.C. § 303(a). Section 302 provides copyright in a work "endures for a term consisting of the life of the author and 70 years after the author's death."

There is a statutory presumption that a certificate of registration is prima facie evidence of a valid copyright when registration is made within 5 years of first publication *See* 17 U.S.C. § 401(c). A party challenging the copyright bears the burden of rebutting the presumption. *See ETS-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1076 (9th Cir. 2000)

Under the 1909 Copyright Act, proper copyright notice must be provided on a published work, otherwise it is automatically injected into the public domain. *Stewart v. Abend*, 494 U.S. 207, 233

(1990); *Twin Books Corp. v. Walt Disney Co.*, 83 F.3d 1162, 1166 (9th Cir. 1996). Proper notice requires the name, initials, mark or symbol of the proprietor, and copyright symbol, "©" and the year of first publication. *Nimmer on Copyright* § 7.14 (2000).

B. Limited Publication

For purposes of the Copyright Act, "the date of publication" is "the earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed." *Hirshon v. United Artist Corp.*, 243 F.2d 640, 644. (D.C. Cir. 1957). A "limited publication" that does not destroy an artist's ownership right is one "which communicates the contents of [the work] to a definitely selected group and for a limited purpose, and without the right of diffusion, reproduction, distribution or sale . . . [T]he circulation must be restricted both as to persons and purpose." *White v. Kimmell*, 193 F.2d 744, 746-747 (9th Cir. 1952). "[T]he principle is discernible that it takes more publication to destroy a . . . copyright than to perfect a statutory copyright. . . . In each case the courts appear to treat the concept of 'publication' as to prevent piracy." *Id.* at 644-645.

In *Hirshon*, the record showed:

> 2,500 copies of [the artist's] song were printed and that some 2,000 of them were distributed to broadcasting stations and professional musicians for 'plugging' purposes . . . Not a single copy was sold. No license or other per-

> mission was given to anyone to perform or otherwise use the song. Nothing was said or done, beyond the described distribution, to give any recipient of a copy the impression that he could make any use of it without first obtaining the proprietor's license through the stated licensing agent.

Id. at 645. Under these circumstances, the circuit court held there was only "limited publication," insufficient to destroy the artist's copyright. The court stated, "'Clearly, if the publication is limited both as to the persons allowed to use the work and to the use which such persons may make of the work, a general publication does not occur.'" *Id.* (citing Nimmer, *Copyright Publication*, 56 Col.L. Rev. 185, 200 (1956)).

Several of the at-issue photographs were publicity stills for Warner Brothers' "The Prince and the Showgirl" and Twentieth Century Fox's "Bus Stop." No copyright notice appears on the photos. The photographs appeared in "press books" and "lobby cards" to promote the two movies. Essentially, the photographs were distributed to movie theater owners and others who might wish to promote the movies in 1956 and 1957.

The parties do not provide evidence indicating the copyright status of the movie stills when they were taken, if Milton Greene was employed by the studios when he took the photos, or if he sold or licensed the photos to the studios. In any event, the distribution of photos for promotion of the two movies constitutes a limited publication, not a general publication, for the purposes of the Copyright Act. There is no evidence showing the photos were sold, purchased or generally available to the public. They were distributed to a limited group, members of the press and theater owners, for the limited purposes of promoting the movies.

Defendants offer the testimony of Howard Mendelbaum, who they request to designate as an expert on movie memorabilia. Mr. Meldelbaum declares he has worked in memorabilia stores since the early 1970s, organizing movie memorabilia. Mendelbaum Decl. at ¶ 11. He declares these publicity stills were published in magazines and newspaper advertisements all over the country as part of the publicity campaigns for the two movies. However, Mr. Mendelbaum does not identify any particular magazines or newspapers that ran advertisements with the at-issue photographs in them. Mr. Mendelbaum's testimony is too general to raise a triable issue of fact as to whether the specific photographs, catalogue numbers 3916, 6412, 4149, 65440, 3480, 33016 and 18400, were widely distributed or published in newspapers and magazines. Mr. Mendelbaum identifies only catalogue number 33016 as appearing in *Look* magazine in May 1996, accompanying an article about Marilyn Monroe and the movie "Bus Stop." However, as discussed below, the photograph that appeared in *Look*, Exhibit F to Mr. Mendelbaum's declaration, is not the same photograph as catalogue number 33016.

None of the at-issue photos were published in 1956 or 1957 for purposes of the Copyright Act by virtue of them being movie stills included in press books and lobby cards.

C. Copyright Notice in Norman Mailer's "*Marilyn*"

In 1973, Norman Mailer published the book *Marilyn*, which contains several of the photographs at issue in this case. The book states the at-issue photographs were previously copyrighted by Milton Greene. However, Milton Greene never registered the photographs with the Copyright Office. Defendants argue the statement in Mailer's book rebuts the presumption that Plaintiff has a valid copyright on the photos. They argue that, if the photos were in fact copyrighted before 1973, they might have been copyrighted earlier than the 28 years Plaintiff had to renew its registration for the photographs. However, no evidence shows the photographs were either published or formally copyrighted more than 28 years before Joshua Greene filed the copyright registrations for these photos in 1994.

Plaintiff contends the phrase "previously copyrighted" in reference to Milton Greene's photographs in Norman Mailer's book is not legally significant. Because an artist automatically owns the copyright to his work, absent some other agreement with an employer or the like, the photographs were copyrighted by virtue of their creation. Absent authority to the contrary, the Court finds the Mailer book does not rebut the validity of Plaintiff's copyrights to the photographs that were published in the book.

D. Prior Litigation

In 1999, a district court in New York ruled 105 photographs were in the public domain, some of which Plaintiff claimed it owned. The case, *Shaw v. Rizzoli*, 1999 WL 160084 (S.D.N.Y. 1999) did not address any of the 17 photographs at issue in this case. However, some of the photographs at issue here were registered under the same copyright registration as some of the photos held to be uncopyrightable in *Rizzoli*. Defendants argue Plaintiff cannot hold the copyright to every photograph it attempted to register under registrations VA 273-327, VA 273-324, VA 273-348, and VA 273-323 because some of the photos were in the public domain. Plaintiff's rely on *Grundberg v. Upjohn Co.*, 137 F.R.D. 372 (D. Utah 1991).

Validity of registration is determined by compliance with the specific requirements of 17 U.S.C. section 409, which requires the person seeking the copyright to describe the copyrighted material in order to put the public on notice of what material is protected under the copyright. *Id.* at 382. The party seeking the copyright in *Grundberg* attempted to register multiple unpublished works as a single unpublished "collection" under section 408 of the Copyright Act. *Id.* at 383. The court recited the requirements for doing so:

> [A] combination of such elements shall be considered a "collection" if: (1) The elements are assembled in an orderly form; (2) the combined elements bear a single title identifying the collection as a whole; (3) the copy-

> right claimant in all of the elements, and in the collection as a whole, is the same; and (4) all of the elements are by the same author, or, if they are by different authors, at least one of the authors has contributed copyrightable authorship to each element.

Id.[1] The court also explained, "[r]egistration of an unpublished 'collection' extends to each copyrightable element in the collection and to the authorship, if any, involved in selecting and assembling the collection." *Id.* (citing 37 C.F.R. § 202.3(b)(3)(i)(B) (1990)).

The *Grundberg* court found the documents at issue did not meet the threshold requirement of a "collection" because no single author had contributed to all the documents in the purported collection. However, the court did not rule the party seeking protection could not have asserted its rights for the documents it authored because it registered copyrightable and non-copyrightable documents together. Although it ruled the party had not obtained a valid copyright certificate, the court conducted an inquiry into the authorship of each of the specific documents the party sought to be protected. *Id.* at 384-385, 387. The court ruled there could be no copyright protection for the documents at issue because the party seeking protection had not presented any evidence that it or its employees had authored those documents. *Id.* at 387-388.

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[1] In addition, "a collection of non-copyrightable material may qualify for protection if original skill and labor is expended in creating the work. The mere fact that component parts of a collective work are neither original to the plaintiff nor copyrightable by the plaintiff does not preclude a determination that the combination of such component parts as a separate entity is both original and copyrightable." *Apple Barrel Productions, Inc. v. Beard*, 730 F.2d 384, 388 (5th Cir. 1984) (relying on 1 *Nimmer on Copyright* §§ 3.02, 3.03).

The *Grundberg* case does not support Defendants' argument that the photographs at issue in this case, listed in the same registration as other photos found to be in the public domain in *Rizzoli*, are not subject to Plaintiff's copyright.[2] Because the *Rizzoli* case did not deal with the 17 photographs at issue in this case, its holding does not control this Court's inquiry.

E. Defenses

1. Abandonment

"Abandonment occurs only if there is an intent by the copyright proprietor to surrender rights in his work. There is, moreover, strong authority holding that an overt act evidencing such an intent is necessary to establish abandonment." 4 *Nimmer on Copyright* § 13.06 (2000). The wide and general circulation of copies of a work by the copyright owner, or with his acquiescence, without a copyright notice, may constitute an overt act indicating an intent to abandon copyright. *See DeSilva Const.*

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[2] Defendants' argument is also not supported by the other cases, they cite, *Carol Barnbart Inc. v. Economy Cover Corp.*, 594 F.Supp. 364, 414 (2d Cir. 1984) and *Masquerade Novelty, Inc. v. Unique Industries, Inc.*, 912 F.2d 653, 669 (3d Cir. 1990), which deal with whether objects that are "useful" or "utilitarian" are copyrightable

Corp. v. Herrald, 213 F. Supp. 184 (M.D. Fla. 1962) (unrestricted limited distribution of architectural plans to a limited group without an affixed copyright notice plus unrestricted exhibition of the structure held to be abandonment); *Lopez v. Electrical Rebuilders, Inc.*, 416 F. Supp. 1133 (C.D. Cal. 1976) (plaintiff's acquiescence to widespread industry use of work without copyright notice constituted abandonment).

From the time the at-issue movie stills were distributed in movie theaters nation-wide without a copyright notice in 1956 and 1957, to the time of Milton Greene's death in 1985, Milton Greene never sought to claim the copyright to the movie stills. In addition, for the 10 years after Milton Greene's death, his trust never sought to claim the copyright. If Milton Greene owned the copyrights to his movie stills, rather than Warner Brothers and Twentieth Century Fox, he abandoned them by allowing the movie studios to distribute the photographs to movie theaters throughout the country with no copyright notice and never seeking to reassert his ownership interest in them.[3]

While there is the lack of a triable issue whether Milton Greene abandoned his copyrights in the movie stills at issue, the evidence does not support Defendants' argument that he abandoned the other at-issue photographs. Defendants argue Milton Greene abandoned his copyright in nine other photos because each appeared in a book.[4] This is not the kind of wide distribution of a work of art with the artist's acquiescence other courts have found to constitute abandonment. There is no evidence before the Court regarding the distribution of these books. There is no evidence Milton Greene, his trust, or Plaintiff knew or should have been aware of the existence of these books.

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[3] The argument that Milton Greene abandoned his copyrights to the movie stills, had he ever owned them, is supported by David Conover's giving copyright credit to Twentieth Century Fox for the "Bus Stop" movie still that appears in his 1984 book, *Finding Marilyn, A Romance*, catalogue number 4149.

There remains no issue of triable fact that, had Milton Greene owned the copyrights to the movie stills, he abandoned them.

2. Laches

To assert the defense of laches, and infringer must show (1) the plaintiff had knowledge of the defendant's infringement, (2) there was inexcusable or unreasonable delay before the plaintiff took action, and (3) the defendant relied on the plaintiff's delay. *Roulo v. Russ Berrie & Co., Inc.*, 886 F.2d 931, 942 (7th Cir. 1989). The period of delay for the determination of laches measures from the time of the act of infringement that is being sued upon. *Hampton v. Paramount Pictures Corp.*, 279 F.2d 100 (9th Cir. 1960).

In this case, the evidence shows Plaintiff knew of Defendants' infringement in October 1998, when Joshua Greene purchased photos from Defendants.

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[4] The books are Conway and Ricci's 1954 book, Oppenheim's 1981 book, Anderson's 1983 book, Conover's 1984 book, and Giles' 1991 book.

Although Plaintiff did not send a "cease and desist" letter, it did file suit less than two years later, in June 2000. This is not an unreasonable delay. In addition, Defendants have not shown evidence that they relied on the delay. They admit they have been selling some of the at-issue photographs since they have been in business, years before Plaintiff was aware of them. This is not a situation where "the owner of a copyright, with full notice of an intended infringement, [] stand[s] inactive while the proposed infringer spends large sums of money in its exploitation, and [] intervene[s] only when his speculation has proved a success." *Haas v. Leo Feist, Inc.*, 234 F. 105, 108 (S.D.N.Y. 1916).

Defendants have not raised a triable issue of fact in support of their defense of latches.

F. Photographs for Which the Presumption of Validity of Plaintiff's Copyright Has Not Been Rebutted

1. Catalogue No. 17835 / Exhibit 3 to the Complaint

Defendants have not presented any evidence demonstrating catalogue number 17835 was previously published before Joshua Greene filed copyright application for it. Summary judgement with regard to this photo is GRANTED in favor of Plaintiff.

2. Catalogue No. 72509 / Exhibit 4 to the Complaint

Catalogue 72509 was first published in Norma Mailer's *Marilyn* in 1973. The book attributed copyright ownership to Milton Greene. It was also published in Nicki Giles' *The Marilyn Album* in 1991 without copyright notice. Trope Decl., Exh. O. However, as this was within 28 years of Joshua Greene's registration of the photo, it does not raise a triable issue to rebut the validity of Plaintiff's copyright registration. There is no evidence the trustees of Milton Greene's trust knew about Giles' use of the photo without a copyright notice. Defendants have not presented any evidence to rebut the presumption that Plaintiff's copyright of this photo is valid. Summary judgement with regard to this photo is GRANTED in favor of Plaintiff.

3. Catalogue No. 17675 / Exhibit 6 to the Complaint

Defendants have not presented any evidence demonstrating catalogue number 17675 was previously published before Joshua Greene filed copyright application for it. They provide a similar photo published in *Modern Screen* magazine. Weich Decl., Exh. A. However, upon examination, this photo is not 17675. Monroe's head is in a different position in the two photos. Summary judgement with regard to this photo is GRANTED in favor of Plaintiff.

4. Catalogue No. 32470 / Exhibit 7 to the Complaint

Catalogue number 32470 is identified by Defendants as being first published in Nicki Giles' *The Marilyn Album* in 1991 without copyright notice. If this was the date of first publication, it is within 28 years of Joshua Greene's registration. There is no evidence the trustees of Milton Greene's trust knew about Giles' use of the photo without a copyright notice. Defendants have not presented any evidence to rebut the presumption that Plaintiff's copyright of this photo is valid. Summary judgement with regard to this photo is GRANTED in favor of Plaintiff.

5. Catalogue No. 24954 / Exhibit 8 to the Complaint

Defendants have not presented any evidence demonstrating catalogue number 24954 was previously published before Joshua Greene filed copyright application for it. Summary judgement with regard to this photo is GRANTED in favor of Plaintiff.

6. Catalogue No. 23635 / Exhibit 7 to the Complaint

Catalogue number 23635 was first published in Norman Mailer's *Marilyn* in 1973. The book attributed copyright ownership to Milton Greene. Defendants have not presented any evidence to rebut the presumption that Plaintiff's copyright of this photo is valid. Summary judgement with regard to this photo is GRANTED in favor of Plaintiff.

7. Catalogue No. 30605 / Exhibit 10 to the Complaint

Defendants have not presented any evidence demonstrating catalogue number 30605 was previously published before Joshua Greene filed copyright application for it. Summary judgement with regard to this photo is GRANTED in favor of Plaintiff.

8. Catalogue No. 21715 / Exhibit 11 to the Complaint

Defendants have not presented any evidence demonstrating catalogue number 21715 was previously published before Joshua Greene filed copyright application for it. Summary judgement with regard to this photo is GRANTED in favor of Plaintiff.

G. Photographs for Which Plaintiff's Copyright Has Been Abandoned

1. Catalogue No. 65440 / Exhibit 1 to the Complaint

Catalogue number 65440 is a movie still used for promoting "The Prince and the Showgirl" in 1957. Mandelbaum Decl., ¶ 17, Exh. D; Weich Decl., ¶¶ 3-4, Exh. B. Although Defendants have not provided evidence to raise a triable issue to rebut the presumption that Plaintiff's copyright is valid, there is no issue of triable fact that Milton Greene abandoned his copyright in this photo. Summary judgement with regard to this photo is GRANTED in favor of Defendants.

2. Catalogue No. 18400 / Exhibit 2 to the Complaint

Catalogue number 18400 is a movie still used for promoting "The Prince and the Showgirl." Mandelbaum Decl., Exh. H. It may have been generally published in Nicki Giles' *The Marilyn Album* in 1991. Trope Decl., Exh. O. This book attributes ownership to Cinema Collectors. This raises a triable issue to rebut the presumption that Plaintiff's copyright is valid. In addition, there is no issue of triable fact that Milton Greene abandoned be copyright in this photo. Summary judgement with regard to this photo is GRANTED in favor of Defendants.

3. Catalogue No. 3480 / Exhibit 2 to the Complaint

Catalogue number 3480 is a movie still used for promoting "Bus Stop" in 1956. Mandelbaum Decl., ¶ 19, Exh. F. It was also published in Joel Oppenheimer's *Marilyn Lives* in 1981. This book attributes ownership of the photo to the Museum of Modern Art Film Stills Archive. Trope Decl., Exh. M. This raises a triable issue to rebut the presumption that Plaintiff's copyright is valid. In addition, there is no issue of triable fact that Milton Greene abandoned his copyright in this photo. Summary judgement with regard to this photo is GRANTED in favor of Defendants.

4. Catalogue No. 4149 / Exhibit 2 to the Complaint

Catalogue number 4149 is a movie still used for promoting "Bus Stop" in 1956. Mandelbaum Decl., ¶ 16, Exh. C. It was also published in David Conover and Mark Ricci's *Finding Marilyn, A Romance* in 1984. Trope Decl., Exh K. The book attributes copyright ownership to Twentieth Century Fox. This attribution raises a triable issue of fact as to Plaintiff's ownership in the photo. In addition, there is no issue of triable fact that Milton Greene abandoned his copyright in this photo. Summary judgement with regard to this photo is GRANTED in favor of Defendants.

5. Catalogue No. 3916 / Exhibit 5 to the Complaint

Catalogue number 3916 is a movie still used for promoting "The Prince and the Showgirl" in 1957. Mandelbaum Decl. ¶ 14, Exh. A. It appeared in Michael Conway and Mark Ricci's *The Films of Marilyn Monroe* in 1964 without copyright notice. Trope Decl., Exh. I. If this was the first general publication, Milton Greene's copyright in the photo would have lapsed in 1992. This raises a triable issue of fact as to Plaintiff's ownership in the photo. In addition, there is no issue of triable fact that Milton Greene abandoned his copyright in this photo. Summary judgement with regard to this photo is GRANTED in favor of Defendants.

6. Catalogue No. 6412 / Exhibit 5 to the Complaint

Catalogue number 6412 is a movie still used for promoting "The Prince and the Showgirl" in 1957. Mandelbaum Decl. ¶ 15, Exh. B. This photo appears in Nicki Giles' *The Marilyn Album*, published in 1991 without copyright notice. Trope Decl., Exh. O. If this was the date of first publication, it is within 28 years of Joshua Greene's registration. There is no evidence the trustees of Milton Greene's trust knew about Giles' use of the photo without a copyright notice. Although Defendants have not provided evidence to raise a triable issue to rebut the presumption that Plaintiff's copyright is valid, there is no issue of triable fact that Milton Greene abandoned his copyright in this photo. Summary judgement with regard to this photo is GRANTED in favor of Defendants.

7. Catalogue No. 33016 / Exhibit 9 to the Complaint

Catalogue number 33016 is a movie still used for promoting "Bus Stop" in 1956. Mandelbaum Decl. ¶ 19, Exh. F. Defendants provide a copy of a photo they purport to be 33016 that appeared in *Look* magazine in May 1956. However, upon examination of the photo in Exhibit J to Trope's declaration, it does not appear to be 33016. Monroe's eyes are pointed in a different direction, and her mouth looks different in the two pictures. Although Defendants have not provided evidence to raise a triable issue to rebut the presumption that Plaintiff's copyright is valid, there is no issue of triable fact that Milton Greene abandoned his copyright in this photo. Summary judgement with regard to this photo is GRANTED in favor of Defendants.

H. Photographs for Which There Remains a Triable Issue of Fact

1. Catalogue No. 61256 / Exhibit 7 to the Complaint

Catalogue number 61256 was first published in Norma Mailer's *Marilyn* in 1973, which attributes copyright to Milton Greene. It also appeared in Janice Anderson's *Marilyn Monroe* in 1983, which attributes ownership to the Camera Press, London. This raises a triable issue of fact to rebut Plaintiff's ownership of the photo, but it does not prove Plaintiff's copyright is invalid. Summary judgement with regard to this photo is DENIED.

2. Catalogue No. 25835 / Exhibit 8 to the Complaint

Catalogue number 25835 was first published in Norma Mailer's *Marilyn* in 1973. The book attributed copyright ownership to Milton Greene. It also appeared in Janice Anderson's *Marilyn Monroe* in 1983, which attributes ownership to the Korbal Collection, London. This raises a triable issue of fact to rebut Plaintiff's ownership of the photo, but it does not prove Plaintiff's copyright is invalid. Summary judgement with regard to this photo is DENIED.

I. Statutory Damages

"In a case where the infringer sustains the burden of proving, and the court finds, that such infringer was not award and had no reason to believe that his or he acts constituted an infringement of copyright the court in its discretion may reduce the award of statutory damages to a sum of not less than $200." 17 U.S.C. § 504(2). Infringers have been found to be "innocent infringers" in cases where, for example, "[m]any unauthorized copies of the [art work] had circulated over the years without copyright notice before defendants copied [and i]dentical [works] had been copyrighted by . . . other persons." *Stuff v. E.C. Publications, Inc.*, 342 F.2d 143, 144 (2d Cir. 1965).

Defendants do not raise a triable issue of fact as to their being "innocent infringers." They admit to being generally aware of copyright laws. The five books they identify as having included an at-issue photo without copyright attribution to Milton Greene is insufficient to raise a triable issue whether Defendants were unaware they were infringing on the copyrights of other photos. As in the *Stuff* case, more would be required.

In addition, Defendants argue they can be found liable for only two instances of infringement because the at-issue photos appear in only two published collections, Norman Mailer's *Marilyn* and Joshua Greene's *Milton's Marilyn*. However, this is not a situation where Defendants copied "various separate portions or passages of plaintiff's work." 4 *Nimmer on Copyright* § 14.04[E][1]. Unlike the plaintiff in *Stokes Seeds Ltd. v. Geo. W. Park Seed Co., Inc.*, 783 F. Supp. 104, 106 (W.D.N.Y. 1991), which "[did] not claim that it ha[d] ever reproduced or printed the photographs independently of the books," Milton Greene created photographs for individual production and sale decades before others compiled his photographs in their own books. As the *Grundberg* court stated, "Registration of an unpublished 'collection' extends to each copyrightable element in the collection." 137 F.R.D. at 383.

Plaintiff is entitled to statutory damages for each of the photos for which Defendants were unable to present evidence to rebut the presumption of a valid copyright and for which Defendants have not shown Milton Greene's abandonment of his copyright interest. There remains a triable issue of fact with regard to copyrights of only two photographs. The Court declines to make a determination of a proper damages award at this time because insufficient evidence has been presented on the issue.

DATED: June __, 2001.

/s/ GARY L. TAYLOR
GARY L. TAYLOR
UNITED STATES DISTRICT JUDGE

UNITED STATES DISTRICT COURT,
C.D. CALIFORNIA.

MILTON H. GREENE ARCHIVES, INC.

v.

BPI COMMUNICATIONS INC., et al.

No. SACV04635GLT(MLGX).
June 17, 2005.

Lisa Bredahl, Deputy Clerk, for Plaintiff(s).

PROCEEDINGS [In Chambers]	**Order on Plaintiff's *Ex Parte* Application for an Order Vacating June 7, 2005 Order on Motions for Summary Judgment and Setting Oral Argument on Such Motions**

TAYLOR, J.

The Court has reviewed the briefing on Plaintiff's ex parte application. Plaintiff's ex parte application is DENIED, First, Plaintiff is not entitled to oral argument. L.R. 7-15; *Greene v. WCI Holdings Corp.*, 136 F.3d 313, 316 (2d Cir.1998) (finding every circuit to consider the issue has determined "the 'hearing' requirements of Rule 12 and Rule 56 do not mean . . . an oral hearing is necessary, but only require . . . a party be given the opportunity to present its views to the court"). Here, Plaintiff was afforded an opportunity to be heard. Second, Plaintiff has not specifically shown what it would have presented to the Court at oral argument that was not presented in the briefing. Third, the evidence to which Plaintiff seeks to respond was not relied on by the Court in its June 7, 2005 Order.

The Court has received a proposed judgment from Defendant. Any objections to the *form* of the proposed judgment should be submitted by Plaintiff by June 22, 2005.

C.D.Cal., 2005.
Milton H. Greene Archives, Inc. v. BPI Communications, Inc.
Not Reported in F.Supp.2d, 2005 WL 1651050 (C.D.Cal.)

UNITED STATES COURT OF APPEALS, NINTH CIRCUIT.

MILTON H. GREENE ARCHIVES, INC.,
Plaintiff-Appellant,

v.

BPI COMMUNICATIONS, INC.,
Erroneously Sued As
VNU Business Media, Inc.; et al.,
Defendants-Appellees.

Nos. 05-56194, 06-55530.
Argued and Submitted May 9, 2007.
Filed March 24, 2009.

Surjit P. Soni, Esq., Soni Law Firm, Pasadena, CA, *Plaintiff-Appellant.*

Andrew J. Thomas, Davis Wright Tremaine, LLP, Los Angeles, CA, *for Defendants-Appellees.*

Appeal from the United States District Court for the Central District of California, ALICEMARIE H. STOTLER, District Judge, Presiding. D.C. No. CV-04-00635-AHS.

Before:

NOONAN, KLEINFELD and PAEZ, *Circuit Judges.*

MEMORANDUM*

Milton H. Greene Archives, Inc. appeals the district court's grant of summary judgment and attorneys' fees in favor of BPI Communications, Inc. We affirm.

The photographs at issue entered the public domain when Milton H. Greene permitted them to be distributed to magazines, newspapers, and local theaters. This was a general publication, not a limited publication, because "tangible copies of a work [were] . . . made available to the general public." *Am. Vitagraph, Inc. v. Levy*, 659 F.2d 1023, 1027 (9th Cir. 1981) (quoting 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 4.04 (1978)). For the pictures at issue that were submitted to studios and publicists but were not used as broadly as the others or at all, the general publication doctrine still applies, because "an authorized offer [was] made to dispose of the work in any such manner *even if . . . such disposition [did] not in fact occur*." *Id.* (emphasis added). Distribution of the photographs was not a limited publication, because Greene provided the photographs with "the right of diffusion, reproduction, [or] distribution." *Id.* (quoting *White v. Kimmell*, 193 F.2d 744, 746-47 (9th Cir. 1952)).

The district court did not abuse its discretion in considering the newspaper and magazine clippings. They are self-authenticating, ancient documents whose authenticity is undisputed. Fed.R.Evid.

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* This disposition is not appropriate for publication and is not precedent except as provided by 9th Cir. R. 36-3.

803(16), 902(6)-(7), 1003. Greene could have sought to include the remainder of any clipping that it wanted the district court to consider. Fed.R.Evid. 106. Any error in considering the testimony of David Weitzner, and such other evidentiary errors as Greene claims were made, were harmless. Fed.R.Civ.P. 61.

The district court did not abuse its discretion in awarding reasonable attorneys' fees under 17 U.S.C. § 505. Its discussion of the parties' arguments shows that it considered the relevant factors. Though the court did not explain in any detail its views on each of the many issues raised by Greene, the context, including plaintiff's attorney's abusive litigation tactics, and the decision itself make clear that the court accepted defendant's arguments. *Smith v. Jackson*, 84 F.3d 1213, 1221 (9th Cir. 1996); *Maljack Prods., Inc. v. GoodTimes Home Video Corp.*, 81 F.3d 881, 890 (9th Cir. 1996). The award was not an abuse of discretion in the circumstances; the court's conclusions regarding the availability and amount of fees were not "based on an inaccurate view of the law or a clearly erroneous finding of fact." *Entm't Research Group, Inc. v. Genesis Creative Group, Inc.*, 122 F.3d 1211, 1217 (9th Cir. 1997) (quotation marks and citation omitted).

AFFIRMED.